

This Opinion Is Not a
Precedent of the TTAB

Hearing: February 25, 2021

Mailed: September 30, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Lisbeth W. Roy, DO, PA

v.

Charles E. Runels, Jr.

Cancellation No. 92065804

Courtney L. Stuart-Alban of Stuart Alban Law
for Lisbeth W. Roy, DO, PA, Petitioner.

Patrick J. Arnold Jr. of McAndrews, Held & Malloy, Ltd.
for Charles E. Runels, Jr., Respondent.

Before Taylor, Heasley, and Dunn, Administrative Trademark Judges.

Opinion by Dunn, Administrative Trademark Judge:

Charles E. Runels, Jr. (Respondent or Runels), a doctor specializing in cosmetic procedures, was an early adopter of a procedure used to extract and prepare a patient's blood so that it could be reinjected into the patient for cosmetic purposes. Briefly, blood contains platelets that assist in blood clotting; during the procedure, blood is drawn from a patient and processed in a centrifuge, which separates platelet

rich plasma (or “PRP”), from the blood; the PRP is then reinjected just below the patient’s skin to cosmetically improve the patient’s appearance.¹ It can also be injected into genital areas to address sexual dysfunction.²

As Respondent Runels used PRP injections in these different ways, he acquired trademark registrations for various cosmetic medical services in International Class 44, all featuring injections or microneedling³ of PRP, or PRP to which another substance has been added, namely platelet rich fibrin matrix (or “PRFM”).⁴ Respondent uses the subject marks largely through his licensees, with about 1400-2000 licenses for each of the subject trademarks, including Lisbeth Roy, the sole proprietor of Petitioner.⁵ This proceeding arises from the breakup in Runels and Roy’s professional relationship, and Petitioner’s effort to cancel Respondent Runels’ trademark registrations listed below:

Registration/Status	Mark ⁶	Services
Registration No. 3965319 (filed 09/12/10, issued 05/24/2011, renewed)	VAMPIRE FACELIFT (FACELIFT disclaimed)	Skin treatment, namely, the injection of blood derived growth factors including platelet rich fibrin matrix into the face for the purpose of rejuvenation of the face

¹ 47 TTABVUE 50, 49 TTABVUE 18-27, 40-43.

² 49 TTABVUE 45-48.

³ We take judicial notice that the U.S. Food & Drug Administration defines “microneedling devices” as “instruments with technological features, such as many small needles, tips, or pins on the surface, which are repeatedly inserted and removed into the skin.” <https://www.fda.gov/medical-devices/aesthetic-cosmetic-devices/microneedling-devices>.

⁴ 47 TTABVUE 50.

⁵ 47 TTABVUE 56, 64 TTABVUE 3-4, 27.

⁶ All of the marks are registered in standard characters.

Registration/Status	Mark ⁶	Services
Registration No. 3965320 (filed 09/12/10, issued 05/24/2011, renewed)	PRIAPUS SHOT (SHOT disclaimed)	Non-invasive cosmetic medical procedure using blood-derived growth factors including platelet rich fibrin matrix to enhance the size or function of the penis
Registration No. 4100383 (filed 03/18/11, issued 02/14/2012, Sec. 8 filed)	ORGASM SHOT (SHOT disclaimed, Supp. Register)	Non-invasive cosmetic medical procedure namely, the injection of blood-derived growth factors including platelet rich fibrin matrix within the Gspot, clitoris, and/or other vaginal structures to rejuvenate the tissue and facilitate the female orgasm
Registration No. 4103302 (filed 03/18/11, issued 02/21/2012, Sec. 8 filed)	O SHOT (SHOT disclaimed, Supp. Register)	non-invasive cosmetic medical procedure, namely, the injection of blood-derived growth factors including platelet rich fibrin matrix within the Gspot, clitoris, and/or other vaginal structures to rejuvenate the tissue and facilitate the female orgasm
Registration No. 4121687 (filed 08/17/11, issued 04/03/2012, Sec. 8 filed)	VAMPIRE BREAST LIFT (BREAST LIFT disclaimed)	non-invasive cosmetic medical procedure, namely isolation and injection of blood- derived growth factors, including but not exclusive to platelet rich plasma, for lifting the breast and enhancing nipples and cleavage
Registration No. 4131408 (filed 08/17/11, issued 04/24/2012, Sec. 8 filed)	VAMPIRE NIPPLE LIFT (NIPPLE LIFT disclaimed)	non-invasive cosmetic medical procedure, namely, isolation and injection of blood- derived growth factors, including but not exclusive to platelet rich plasma, for the correction of inverted nipples

Registration/Status	Mark ⁶	Services
Registration No. 4402898 (filed 01/18/13, issued 09/17/2013, Sec. 8 filed)	VAMPIRE FACIAL (FACIAL disclaimed)	non-invasive cosmetic medical procedure using topically applied blood-derived growth factors including platelet rich fibrin matrix on the skin for rejuvenation of the skin

I. BACKGROUND

In April 2010, Respondent Runels met a sales representative for third party Aesthetic Factors LLC.⁷ Aesthetic Factors LLC was promoting the injection of platelet rich fibrin matrix, or PRFM, for cosmetic medicine applications.⁸ Aesthetic Factors LLC had manufactured a new centrifuge system called Selphyl, the first centrifuge system for cosmetic (as opposed to therapeutic) applications, which could be used to separate the patient's blood to derive PRP and PRFM.⁹

The sales representative directed Runels to the research on the Aesthetic Factors' website on how to inject PRFM into the nasolabial folds of the face to create a younger appearance, and gave him a demonstration of the new Selphyl centrifuge system.¹⁰ Respondent purchased the system and immediately developed what he describes as his own method for injecting the PRFM into the face as a filler to create a younger

⁷ 47 TTABVUE 50-51, 49 TTABVUE 21.

⁸ 47 TTABVUE 50, 49 TTABVUE 21-23, 113-116.

⁹ 49 TTABVUE 23, 108-109, 125-126.

¹⁰ 47 TTABVUE 50-51, 49 TTABVUE 21-23, 26-27.

appearance.¹¹ Respondent testified that he did not invent the “Vampire Facelift” but came up with “a method that creates some goodwill surrounding this name.”¹²

Respondent Runels injected PRFM in a patient’s face for the first time in April 2010.¹³ Respondent submitted an email dated April 12, 2010 “which shows [his] communication with one of the first people to make an appointment and to pay for a Vampire Facelift® procedure.”¹⁴ On April 13, 2010, Respondent registered the Internet domain name vampirefacelift.com.¹⁵ Respondent testified that he began advertising VAMPIRE FACELIFT services by email to patients and prospective patients from May 2010 to July 2010, in the form of an email newsletter or personal email correspondence, and through word of mouth.¹⁶ On July 24, 2010, Respondent issued a press release titled “News Tip VAMPIRE FACELIFT,” and offered a free facelift in return for an interview.¹⁷

In September 2010, Respondent filed trademark applications to register the marks VAMPIRE FACELIFT and PRIAPUS SHOT.

¹¹ 49 TTABVUE 27, 94 TTAVUE 34.

¹² 94 TTABVUE 34.

¹³ 49 TTABVBUE 28, 32, 94 TTABVUE 22, 34. Respondent also testified no one witnessed him performing the procedure, and he did not recall the patient’s name. 49 TTABVUE 52.

¹⁴ 64 TTABVUE 6, 50. However, the term VAMPIRE FACELIFT does not appear either in the sender’s email message, which displayed the subject line “Interested in Selphyl Injections,” or in Respondent’s response.

¹⁵ 64 TTABVUE 7, 56.

¹⁶ 64 TTABVUE 7-15, 58, 75-84, 86-87, 72 TTABVUE 186-190, 192. Respondent also testified that his initial marketing of VAMPIRE FACELIFT included “websites, videos” but Respondent did not support this testimony with any record evidence of website pages or videos with his first advertisements of the marks.

¹⁷ 64 TTABVUE 125-126.

Two months later, Aesthetic Factors LLC, the makers of the Selphyl centrifuge system, filed an application to register the mark VAMPIRE FACELIFT TECHNOLOGY for “medical devices, accessories and preparations thereof, namely, kits comprised of a blood transfer device, container with a coagulation activator and a container with or without an anti-coagulant for use in tissue enhancement or reconstruction” (application Serial No. 85171151).¹⁸

In December of that year, the Aesthetic Factors CEO sent Respondent an email “summary of our thoughts” outlining a proposed business deal by which, among other things, Respondent would assign Aesthetic Factors the “TM for vampire facelift” and domain names for its exclusive use, with a license back to Respondent, and Aesthetic Factors would compensate Respondent for instructing physicians in how to perform a vampire facelift in connection with the sale of the Selphyl system, and the agreement would include “a full release of claims by each party.”¹⁹ The proposal did not result in an agreement.²⁰ Two months later, in February 2011, the USPTO refused registration of third party Aesthetic Factors’ mark VAMPIRE FACELIFT TECHNOLOGY because the mark was merely descriptive of the goods, and

¹⁸ 18 TTABVUE 13.

¹⁹ 64 TTABVUE 16, 73 TTABVUE 8.

²⁰ 49 TTABVUE 108-111, 94 TTABVUE 56. Respondent testified “They were using – their name was wrapped up – excuse me. They were using my name – short answer is no, we never – we tried to reach an agreement and we never reached one.” 49 TTABVUE 109-110.

potentially conflicted with Respondent's pending application for VAMPIRE FACELIFT.²¹

On May 11, 2011, the registrations for VAMPIRE FACELIFT and PRIAPUS SHOT issued to Respondent Runels. When asked during discovery whether he started licensing his marks "pretty early on," Respondent testified:²²

A. What's early? I didn't do it until after I had a trademark to do it with, so I'm not sure what you mean by "early on."

Q. In the first year, do you think, of having a trademark registration were you licensing the mark to others?

A. You know, I don't remember when the first people started signing up. I just remember it was slow, like slow to get -- I was -- it wasn't like I was doing ten Vampires a day.

There are no license agreements in the record dated earlier than 2015.²³ Runels testified that he could not recall any names of his early licensees, and that he simultaneously began an outreach effort to curtail unauthorized use of the marks and to attract licensees.²⁴

Respondent kept a list of third party users of the terms he registered, whether practitioners or members of the media. "From the very first day when I trademarked it," Respondent started "keeping track of people using the name," "contacting people," and "sending out letters" to inform third parties of his trademark registrations and to request that they cease use if a competitor and to note his trademark rights if a

²¹ 48 TTABVUE 7-10. No response was made to the refusal, and the application subsequently was abandoned.

²² 49 TTABVUE 107.

²³ Respondent testified "Prior to September 25, 2015, I personally administered the licensing of all of my trademarks." 49 TTABVUE 107.

²⁴ 64 TTABVUE 28, 31.

member of the media.²⁵ Respondent did not maintain copies of the early communications to third party users, and acted primarily through phone calls.²⁶ Respondent would inform third party users of the option of becoming a licensee, and obtained many licensees in that fashion.²⁷ With respect to articles that use the registered terms but do not mention Respondent, Respondent would call, or send letters.²⁸

From March through December 2011, Respondent filed trademark applications to register the marks ORGASM SHOT, O SHOT, VAMPIRE BREAST LIFT, and VAMPIRE NIPPLE LIFT, all for cosmetic medicine services featuring platelet rich plasma (PRP) injections and all based on allegations of use in commerce.

At the end of that year, Lisbeth Roy attended a medical conference sponsored by the PRP centrifuge manufacturer Eclipse Aesthetics, LLC which featured a presentation by Respondent Runels.²⁹ Lisbeth Roy is the sole owner of Petitioner, an S-corporation of Florida, and a licensed Doctor of Osteopathy specializing in sexual health and wellness, including anti-aging, functional, and regenerative medicine.³⁰ At the conference, Runels discussed use of PRP in cosmetic medicine, including a non-invasive version of a facelift which he claimed to have invented and referred to as a

²⁵ 49 TTABVUE 71.

²⁶ 49 TTABVUE 131.

²⁷ 49 TTABVUE 171-173.

²⁸ 49 TTABVUE 121-122, 124-125, 145, 190.

²⁹ 54 TTABVUE 5. Respondent does not contest Petitioner's account but testified "How she came to know of me I have no idea." 49 TTABVUE 159.

³⁰ 54 TTABVUE 2.

“vampire facelift.”³¹ Respondent stated that he owned the intellectual property behind the PRP Vampire Facelift, which he said had been granted to him by the Patent and Trademark Office in recognition of the uniqueness of the procedure.³²

Shortly thereafter, in December 2011, Lisbeth Roy purchased a PRP centrifuge kit from Eclipse Aesthetics, LLC. This made her an automatic member of Respondent Runels’s Vampire Licensing Club, with the right to perform the Vampire Facelift for one year; to access Respondent’s members-only portal; and to be listed as a Vampire Facelift provider on Respondent’s website.³³ She signed no written contract at that time.³⁴ The record includes no written license or contract formed then between any of the three: Eclipse Aesthetics, LLC, Respondent, and Roy.

By April 2012, registrations issued to Respondent for the marks VAMPIRE FACELIFT, PRIAPUS SHOT, ORGASM SHOT, O SHOT, VAMPIRE BREAST LIFT, and VAMPIRE NIPPLE LIFT.

In June 2012, Respondent Runels and Eclipse Aesthetics, LLC executed an agreement titled “Exclusive Trademark License” by which, for a three year term, Respondent granted Eclipse “the exclusive, world-wide, non-revocable, sublicensable license in and to the Trademark [defined as VAMPIRE FACELIFT, the subject of Registration No. 3965319] for the purpose of utilizing and sublicensing the

³¹ 54 TTABVUE 5.

³² 54 TTABVUE 5. Roy testified “At the time, with no knowledge of intellectual property law, and without thinking too much about it, I understood from Defendant’s representations that he had patent rights to the medical processes that I would need to license to use.” *Id.*

³³ 54 TTABVUE 5-6.

³⁴ 54 TTABVUE 6.

Trademark in the field of use [defined as the skin treatment market, namely, through the injection of blood-derived growth factors in the face for the purpose of rejuvenation of the face].”³⁵ The agreement gave Eclipse a right of first refusal with respect to any additional trademarks for use in connection with PRP procedures.³⁶

On January 18, 2013, Respondent Runels applied to register the term VAMPIRE FACIAL.

Two months later, in March of that year, Dr. Julian Gallo, a board-certified facial plastic and reconstructive surgeon based in Miami, Florida performed a Vampire Facial on celebrity Kim Kardashian, which was filmed and aired on the television show “Kourtney and Kim Take Miami.”³⁷ In addition to the procedure being aired on television, the picture below was posted to Ms. Kardashian’s Instagram Account, and went viral.³⁸

³⁵ 49 TTABVUE 146, 54 TTABVUE 5, 65 TTABVUE 61-68 (license); 64 TTABVUE 34 (declaration regarding agreement).

³⁶ 65 TTABVUE 66.

³⁷ 49 TTABVUE 145-146, 51 TTABVUE 3, 49 TTABVUE 17-18, 144-146, 164-165, 170-171, 54 TTABVUE 7.

³⁸ 47 TTABVUE 65, 49 TTABVUE 170, 54 TTABVUE 7. The actual Instagram post is not part of the record, only the photo.



Figure 1 Kim Kardashian during VAMPIRE FACIAL

The procedure was initially misidentified as the Vampire Facelift (involving injections), and later correctly identified as the Vampire Facial (involving microneedling).³⁹ The Kardashian Instagram post and show generated “millions of dollars of free press,” public interest in “vampire” procedures grew exponentially, and Respondent benefitted from the interest.⁴⁰ Respondent posted Ms. Kardashian’s Instagram picture of her VAMPIRE FACIAL prominently on his website and asserted that the procedure was performed by one of his licensees.⁴¹

Also in March 2013, Lisbeth Roy paid to attend a two-day training session with Respondent to learn how to inject PRP into genitalia, and was told by Respondent that the O SHOT and P SHOT were proprietary medical procedures requiring monthly fees if she wanted to offer the shots in her practice.⁴² No written license

³⁹ 49 TTABVUE 164-165.

⁴⁰ 49 TTABVUE 165-166, 170, 54 TTABVUE 7.

⁴¹ 47 TTABVUE 65, 49 TTABVUE 144, 54 TTABVUE 7.

⁴² 54 TTABVUE 7-8.

resulted.⁴³ At some time after the March training, Roy suggested and Respondent Runels agreed that Roy would also teach the PRP injection procedure.⁴⁴ Roy received payment in the form of a portion of the licensing fees when healthcare providers she trained became licensees.⁴⁵

In June 2013, Eclipse Aesthetics, LLC notified Roy that “if [she] wished to continue providing the Services, [she] would need to pay fees directly to [Respondent].”⁴⁶ Roy did start paying fees directly to Respondent, and she was not required to sign a written contract or license in order to continue providing the Services.⁴⁷

On September 17, 2013, the last of Respondent’s subject registrations (VAMPIRE FACIAL) issued.

In June 2015, Respondent’s exclusive license with Eclipse for the VAMPIRE FACELIFT mark expired.

In September 2015, Respondent created the American Cosmetic Cellular Medicine Association (ACCMA) to act as his licensing agent.⁴⁸ At that time, in contrast to his earlier practice of issuing informal licenses with oral provisions for quality control, Respondent began requiring licensees to “click through” an online license agreement

⁴³ 54 TTABVUE 8.

⁴⁴ 54 TTABVUE 8, 64 TTABVUE 5.

⁴⁵ 94 TTABVUE 13.

⁴⁶ 54 TTABVUE 6.

⁴⁷ 54 TTABVUE 6.

⁴⁸ 64 TTABVUE 28-29. After eighteen months Respondent shortened the name to Cellular Medicine Association, or CMA. 64 TTABVUE 29.

on his website.⁴⁹ Respondent and his intellectual property manager issued cease and desist letters to third-party users, both practitioners and media outlets, and later shared this task with outside counsel.⁵⁰ The early letters invited the practitioners to become licensees instead of being sued for infringement (as shown below, “I’d rather become colleagues instead”).⁵¹



Figure 2 sample of Respondent's cease and desist postcard⁵²

⁴⁹ 64 TTABVUE 32-33.

⁵⁰ 49 TTABVUE 97- 99, 190, 64 TTABVUE 60.

⁵¹ 49 TTABVUE 172.

⁵² 64 TTABVUE 37, 65 TTABVUE 92.

Respondent testified that “in the vast majority of cases,” following a communication from Respondent, the infringement ceased and many of those contacted became new licensees.⁵³

The letters did not stop all third party uses of the registered terms.⁵⁴ Respondent lists on his website “imposters,” a chart with names and addresses around the world of the third parties who use the registered marks for the same services offered by Respondent, and who continue to use the registered terms after being advised of Respondent’s trademark registrations and being asked to cease and desist their use.⁵⁵ With respect to media, sometimes Respondent got results, sometimes the media argued with him, and sometimes they ignored him.⁵⁶ Respondent has never filed a lawsuit, or taken action other than calling or sending correspondence, against third parties who continue to use the registered marks after being advised of his trademark registrations.⁵⁷

On March 3, 2016, Respondent and Petitioner entered a written licensing and teaching agreement. Less than a year later, on February 16, 2017, Respondent terminated the agreement.⁵⁸ Petitioner was “not given any advance notice or time to ramp down my use of the Marks, nor was I provided with an explanation. My

⁵³ 49 TTABVUE 71-72, 191, 64 TTABVUE 38.

⁵⁴ 49 TTABVUE 64.

⁵⁵ 49 TTABVUE 64-65.

⁵⁶ 49 TTABVUE 190.

⁵⁷ 47 TTABVUE 15, 64; 49 TTABVUE 64.

⁵⁸ 54 TTABVUE 11.

attempts to communicate with Defendant were rebuffed.”⁵⁹ On April 4, 2017, Petitioner filed the petition for cancellation.

Petitioner commenced this proceeding in 2017 with multiple claims against each registration.⁶⁰ The petition for cancellation was amended twice by Petitioner, and by the Board’s August 8, 2018 order addressing the motion to dismiss the second amended petition to cancel. As established by the Board’s order, Petitioner’s operative petition to cancel (16 TTABVUE) pleads claims of genericness against all registrations except Registration No. 3965320 (PRIAPUS SHOT), abandonment based on naked licensing and fraud based on unlawful use against all registrations; claims of fraud based on knowledge of third party generic use against Registration Nos. 3965319 (VAMPIRE FACELIFT); 4121687 (VAMPIRE BREAST LIFT); 4131408 (VAMPIRE NIPPLE LIFT); and 4402898 (VAMPIRE FACIAL); and claims of mere descriptiveness against Registration Nos. 4131408 (VAMPIRE NIPPLE LIFT) and 4402898 (VAMPIRE FACIAL).

The following chart summarizes the claims pleaded against the subject registrations:

Registration/Mark	Claims
3965319 VAMPIRE FACELIFT	genericness abandonment based on naked licensing fraud based on unlawful use fraud based on generic use

⁵⁹ 54 TTABVUE 11.

⁶⁰ Respondent’s Registration Nos. 4232767 and 4232768 also were the subject of the petition for cancellation. As discussed later in this decision, on May 31, 2019, after the commencement of this proceeding, both registrations were cancelled under Trademark Act Section 8, 15 U.S.C. § 1058.

3965320 PRIAPUS SHOT	abandonment based on naked licensing fraud based on unlawful use
4100383 ORGASM SHOT	genericness abandonment based on naked licensing fraud based on unlawful use
4103302 O-SHOT	genericness abandonment based on naked licensing fraud based on unlawful use
4121687 VAMPIRE BREAST LIFT	genericness abandonment based on naked licensing fraud based on unlawful use fraud based on generic use
4131408 VAMPIRE NIPPLE LIFT	genericness mere descriptiveness abandonment based on naked licensing fraud based on unlawful use fraud based on generic use
4402898 VAMPIRE FACIAL	genericness mere descriptiveness abandonment based on naked licensing fraud based on unlawful use fraud based on generic use

Respondent's answer, filed December 18, 2017, denies the salient allegations of the second amended petition and pleads the affirmative defense of licensee estoppel.⁶¹

Both parties filed briefs⁶² and participated in an oral hearing.

⁶¹ Respondent's affirmative defenses attacking the sufficiency of the pleaded claims were rendered moot by the Board's August 8, 2018 order (24 TTABVUE).

⁶² Attached to his brief, Respondent submitted 200 pages comprising two unreported district court decisions, nine non-precedential Board decisions, and, inexplicably, one precedential Board decision [*Performance Open Wheel Racing, Inc. v. United States Auto Club Inc.*, 2019 USPQ2d 208901 (TTAB 2019)], which required only a legal citation. District court discovery differs in significant aspects from discovery under the Board's rules, and so we need not

We grant the petition for cancellation in part and deny in part.

I. THE RECORD

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the files of the involved registrations. The record also includes the following testimony and documentary evidence:

A. Petitioner's Testimony:

Declarations of Lisbeth W. Roy, DO, PA with exhibits;⁶³

Declaration of Dr. Julian Gallo, plastic surgeon;⁶⁴

Petitioner also submitted the following exhibits by unnumbered notices of reliance (NOR):

NOR: Respondent's responses to written discovery;⁶⁵

NOR: Application file of third party Aesthetic Factors LLC for abandoned VAMPIRE FACELIFT TECHNOLOGY mark;⁶⁶

NOR: Excerpts from the discovery deposition of Respondent Charles E. Runels, Jr. with exhibits;⁶⁷

distinguish in this decision non-binding district court decisions on striking evidence not produced in discovery. The non-precedential Board cases involve facts so different from those present here that we are not persuaded that a similar outcome is warranted.

⁶³ 54 TTABVUE (case in chief), 101 (rebuttal).

⁶⁴ 51 TTABVUE.

⁶⁵ 47 TTABVUE. Petitioner also submitted under notice of reliance copies of licensing agreements and cease and desist communications produced by Respondent in response to Petitioner's discovery requests. 56 TTABVUE. Some were authenticated during Respondent's discovery deposition. Because the Board's rules specifically state that documents produced in discovery may not be submitted solely by notice of reliance, the documents not specifically addressed in the deposition have been given no consideration. Trademark Rule 2.120(k)(3)(ii).

⁶⁶ 48 TTABVUE.

⁶⁷ 49-50 TTABVUE.

NOR: Internet materials to demonstrate how the public perceives terms used in the registered marks, and the term PRP;⁶⁸

NOR: Internet materials and official records regarding use of the term VAMPIRE FACIAL by Dr. Gallo and celebrity Kim Kardashian when describing the 2013 cosmetic procedure performed on Kim Kardashian.⁶⁹

B. Respondent's Testimony:

Declaration of Charles E. Runels, Jr. with exhibits;⁷⁰

Respondent also submitted by a notice of reliance:

Petitioner's discovery responses and excerpts from the discovery deposition of Respondent Charles E. Runels, Jr. (for fuller context pursuant to Trademark Rule 2.120 (k)).⁷¹

Respondent has submitted under seal (confidential information barred from public view) thousands of pages of evidence in the form of exhibits to his declaration (72-93, 97 TTABVUE). Respondent's declaration describes some of this same evidence as "an advertisement"⁷² or as "publicly available." See, for example, Exhibit 159, which comprises some eighty pages designated "confidential" but which were submitted as a "printout of my publicly available website as of July 31, 2019, which indicates my

⁶⁸ 52-53, 55, 99 TTABVUE.

⁶⁹ 100,102-103 TTABVUE.

⁷⁰ 64-93 TTABVUE.

⁷¹ 94 TTABVUE.

⁷² We take judicial notice that the word "advertisement" is defined as "a public notice, especially: one published in the press or broadcast over air." *Merriam-Webster.com Dictionary*, Merriam-Webster, <https://www.merriam-webster.com/dictionary/advertisement>. Accessed 25 Sept. 2021. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff'd*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016).

marketing and enforcement of the registered marks.”⁷³ As another example, Respondent submitted website excerpts about performing procedures under the registered marks which presumably were limited to Respondent’s licensees and thus confidential (88 TTABVUE 10), but have the same description in the declaration, appear in the same document/entry, and have the same confidentiality designation as website excerpts with general legal warnings presumably available to the public and so not confidential (88 TTABVUE 59).

Parties are responsible for reviewing their evidentiary submissions to ensure that the exhibits of record match the description of those exhibits as cited in any notices of reliance or testimony of record, as well as in briefing, and to ensure that both testimony and exhibits receive the appropriate confidentiality designation. The Board’s proceedings are designed to be public, and the improper designation of material as confidential thwarts this objective. *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402 (TTAB 2010). Accordingly, where Respondent’s website is obviously available to the general public (such as pages with general legal warnings), it will be discussed as necessary. See Trademark Rule 2.116(g), 37 C.F.R. §2.116(g) (“The Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.”). Otherwise, confidential information will be described in general terms.

⁷³ 64 TTABVUE 39 (declaration); 87 TTABVUE 130-196 and 88 TTABVUE 3-20 (Exhibit 159).

II. EVIDENTIARY OBJECTIONS

Appended to Respondent's trial brief is his motion to strike Petitioner's evidence of third party use (52, 53, and 55 TTABVUE) because the evidence was not produced during discovery; and to strike Petitioner's rebuttal testimony and notices of reliance (101 TTABVUE 3-7 [Par. 4-15] and 99, 102 and 103 TTABVUE [Exhibits 52-58]) because it exceeds the scope of proper rebuttal.⁷⁴

A. Not produced as responsive to discovery requests

Generally, a party that fails to provide relevant information requested during discovery will be precluded from using that information or witness at trial, unless the failure to disclose was substantially justified or is harmless. *Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1328 (TTAB 2011).⁷⁵ With respect to third party uses, the Board requires a responding party to produce information to the extent it possesses it, but does not require any investigation. *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 10 USPQ2d 1671, 1675 (TTAB 1988). The Board's 2007 adoption of disclosure requirements did not change the fact that there is no duty to conduct an investigation of third party use during discovery. *Kate Spade LLC v.*

⁷⁴ 57 TTABVUE (original motion to strike); 108 TTABVUE 53-58 (motion to strike appended to brief).

⁷⁵ However, it has been long settled that there is no need to produce all trial evidence before trial in Board proceedings, and discovery requests seeking all trial evidence are improper. *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1656 (TTAB 2002) ("We find applicant's interrogatory requests that opposer "identify each and every fact, document and witness in support of its pleaded allegations" to be equivalent to a request for identification of fact witnesses and trial evidence prior to trial, and therefore improper."); *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) §414 (2020) ("A party is not required, in advance of trial, to disclose each document or other exhibit it plans to introduce.").

Thatch, LLC, 126 USPQ2d 1098, 1103 (TTAB 2018).⁷⁶ Evidence of third party use of a term, whether in print or Internet publications, is so commonplace in Board proceedings as to make surprise at trial unlikely. *Sheetz of Del., Inc. v. Doctor's Assocs., Inc.*, 108 USPQ2d 1341, 1348 (TTAB 2013); *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1072 (TTAB 2011).⁷⁷ Moreover, inasmuch as publications in general circulation and Internet materials are available to both parties and have limited probative value (admitted only for what they show on their face), the Board has found the 30-day period between the parties' scheduled testimony periods sufficient to prepare any rebuttal against the evidence of third-party use. *Sheetz of Del., Inc.* 108 USPQ2d at 1348; *Rocket Trademarks Pty Ltd.*, 98 USPQ2d at 1072. *See also Kate Spade LLC v. Thatch, LLC*, 126 USPQ2d 1098, 1102 (TTAB 2018) ("The probative value of non-testimonial evidence of third party use is limited to what it shows on its face; it does not establish the truth of the matter asserted in the documents.").

⁷⁶ *Accord Sheetz of Del., Inc. v. Doctor's Assocs., Inc.*, 108 USPQ2d at 1348 ("Regarding applicant's objection to opposer's notices of reliance on printed publications and Internet postings showing third-party uses of "footlong" to refer to 12-inch sandwiches, it is clear that the objected-to documents were obtained or created by opposer in anticipation of its testimony period and were not responsive documents that were already within its possession or control when opposer was responding to document requests."); *Rocket Trademarks Pty Ltd. v. Phard*, 98 USPQ2d at 1071 ("Regarding opposer's objection to the exhibits on the basis that they were not previously produced in response to opposer's discovery requests, it is clear that the objected-to documents were obtained or created by applicant in anticipation of its testimony period and were not responsive documents that were already within its possession or control when applicant was responding to document requests.").

⁷⁷ We decline Respondent's request (108 TTABVUE 57) to overrule *Sheetz of Del., Inc., supra*, as an outlier. In fact, as this discussion shows, that decision is consistent with other Board cases treating evidence of third-party use before and after its issuance.

Respondent moves to strike Petitioner's evidence of third party use of terms appearing in the subject registrations because the evidence is responsive to Respondent's discovery requests and was not previously disclosed.⁷⁸ Petitioner's notice of reliance indicates the evidence either was collected November 25, 2019 and submitted November 27, 2019 or was collected November 28, 2019 and submitted November 29, 2019. Because there is no indication that Petitioner was in possession of this evidence at the time its discovery responses were served, and the evidence was collected shortly before it was submitted, Respondent's motion to strike the evidence is denied.

B. Improper rebuttal

“[E]vidence offered to rebut must accomplish the function of rebuttal; to explain, repel, counteract, or disprove the evidence of the adverse party.” *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 116 USPQ2d 1869, 1883 (Fed. Cir. 2015) (internal citations omitted). Rebuttal evidence “that raises issues not dealt with by the defense” is improper. 28 Victor James Gold, FEDERAL PRACTICE & PROCEDURE § 6164 (2d ed.). *Accord Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.*, 123 USPQ2d 1844, 1847 (TTAB 2017).

In her case in chief (on the claims that the marks are generic, or in the alternative as to those registered for less than five years, merely descriptive, and have been abandoned through naked licensing) Petitioner submitted testimony and media

⁷⁸ 108 TTABVUE 55-58. Respondent seeks to strike Trial Exhibits 11 (in part), 12-28, 30, 32-33, 36-37, 39-46, and 48-49) located at 52, 53, 55, and 63 TTABVUE.

reports regarding public perception of the term VAMPIRE when used in connection with cosmetic procedures featuring injection or microneedling of growth factors obtained from the patient's blood, including the public response to, and Respondent's promotion of the "vampire facial" performed on celebrity Kim Kardashian.⁷⁹ Respondent's defense contends that PRP is the generic designation for the cosmetic procedures featuring growth factors obtained from the patient's blood, and the Kardashian use of VAMPIRE FACIAL inured to his benefit because Dr. Gallo was a licensee of his VAMPIRE FACELIFT mark.⁸⁰

In rebuttal, Petitioner submitted a declaration addressing public perception of the terms VAMPIRE and PRP when used in connection with cosmetic procedures, and the use of VAMPIRE FACIAL by Kim Kardashian (101 TTABVUE), examples of media use of the term PRP in connection with cosmetic procedures and the term VAMPIRE (99 TTABVUE 9-28), a dictionary definition for "vampire facelift" (99 TTABVUE 29-31), and court documents and media reports regarding the relationship between Respondent, Kim Kardashian, and Dr. Gallo (100, 102-103 TTABVUE).⁸¹

⁷⁹ 49 TTABVUE 17-18, 144-146, 164-165, 170-171, 54 TTABVUE 7. The procedure performed was a VAMPIRE FACIAL, based on topical application of PRP after microneedling, but the procedure initially was misidentified as a VAMPIRE FACELIFT, based on injection of PRP. *Id.*

⁸⁰ 108 TTABVUE 42-43, 49.

⁸¹ 99-103 TTABVUE.

Respondent argues that Petitioner's rebuttal evidence supports her main claims, should have been submitted as part of her case in chief, and should be stricken as exceeding the scope of rebuttal evidence.⁸²

We have carefully considered Petitioner's rebuttal declaration, and the attached notices of reliance, and find that the evidence has the necessary nexus to Respondent's defenses regarding whether PRP is the generic term for the services, and whether Kim Kardashian's VAMPIRE FACIAL was performed by Dr. Gallo in his capacity as Respondent's licensee. *See Belden v. Berk-Tek*, 116 USPQ2d at 1880 ("Each of the points that Mr. Baxter made in his [rebuttal] declaration responds to a statement made in Mr. Clark's declaration."); *Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.*, 123 USPQ2d at 1847 ("We find that Mr. Hallam's testimony rebuts certain testimony and evidence introduced by Applicant in connection with the degree of descriptiveness and the claim of acquired distinctiveness.").

We disagree that Petitioner's choice to refer to rebuttal evidence in her trial brief is any admission of improper rebuttal. *See Belden v. Berk-Tek*, 116 USPQ2d at 1881 ("Evidence admitted in rebuttal to respond to the patent owner's criticisms will commonly confirm the prima facie case. That does not make it necessary to the prima facie case."); *Data Packaging Corp. v. Morning Star, Inc.*, 212 USPQ 109, 113 (TTAB 1981) ("The fact that evidence might have been offered in chief does not preclude its admission as rebuttal."). Once properly of record, evidence may be used for any

⁸² 108 TTABVUE 53-55.

purpose. Trademark Rule 2.122(a), 37 C.F.R. § 2.122(a). Because we find Petitioner's rebuttal evidence relates to Respondent's defenses, Respondent's motion to strike the evidence is denied.

In sum, Respondent's motion to strike evidence for failure to produce it during discovery is denied, and Respondent's motion to strike evidence as improper rebuttal is denied.

III. REGISTRATIONS CANCELLED DURING THE PROCEEDING

If a registration subject to a pending cancellation proceeding is cancelled due to the respondent's failure to file an affidavit of continued use under Trademark Act Section 8, the Board may issue an order requiring the respondent to show cause why judgment should not be entered against him. Trademark Rule 2.134(b); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1471 (TTAB 2014); TBMP 602.02(b). Where no show cause order issues, but the record indicates the reason for the cancellation was Respondent's decision to cease use of the mark, the Board may enter judgment on the claim of abandonment only. *Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, *2 (TTAB 2020); *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1154, 1156 (TTAB 1989).

Here, Registration Nos. 4232767 and 4232768 were cancelled May 31, 2019 for Respondent's failure to file the required Section 8 affidavits of continued use. In its brief, Respondent notes the cancellations, and states "Respondent did not renew them because he and his licensees stopped using these two trademarks after the

commencement of this proceeding.”⁸³ Accordingly, we enter judgment against Respondent on the abandonment claim as to cancelled Registration Nos. 4232767 and 4232768. The pleaded claims against the registrations are dismissed without prejudice.

IV. ENTITLEMENT TO A STATUTORY CAUSE OF ACTION⁸⁴

To establish entitlement to bring a statutory cause of action under Section 14 of the Trademark Act, a plaintiff must demonstrate a real interest in the proceeding and a reasonable belief of damage. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 at *3 (Fed. Cir. 2020) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067 n.4 (2014)). A party in the position of plaintiff may petition for cancellation of a registered mark where cancellation is within the zone of interests protected by the statute, 15 U.S.C. § 1064, and the party’s reasonable belief in damage is proximately caused by continued registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *6-7 (Fed. Cir. 2020), *cert. denied*, ___ S. Ct. ___ (2021).

Here, Lisbeth Roy on behalf of Petitioner has submitted testimony averring that she has offered cosmetic regenerative and sexual wellness procedures based on

⁸³ 108 TTABVUE 10.

⁸⁴ The Board’s decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of “standing.” Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Section 13 and 14 remain applicable. *See Spanishtown Enters., Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020).

injections of platelet rich plasma derived from the patient's blood; and that it is "commercially implausible for me and others to offer these services to the relevant purchasing public without reference to these functional, generic terms to describe the services in the way that will not confuse consumers."⁸⁵ Respondent's answer admits that Petitioner "is an osteopathic physician licensed in the states of Florida and Colorado who offered, as a licensee, the same services that Runels provides under the Marks."⁸⁶ Having established that she is a competitor offering cosmetic procedures using platelet rich plasma derived from the patient's blood, Petitioner has established the necessary entitlement to a statutory cause of action. *Eastman Kodak Co. v. Bell & Howell Document Mgmt. Prods. Co.*, 23 USPQ2d 1878, 1879-1880 (TTAB 1992) ("Opposer clearly has a real interest in this proceeding because it has a present or prospective right to use these numerals descriptively in its business."), *aff'd*, 994 F.2d 1569, 26 USPQ2d 1912 (Fed. Cir. 1993).

We reject Respondent's contention that, apart from any application of licensee estoppel (which is addressed later in this order), two provisions in the licensing agreement between the parties permanently divest Petitioner of entitlement to bring a statutory cause of action against the registrations listed in the agreement.⁸⁷ On March 3, 2016, the parties executed a nine page agreement with 29 numbered provisions titled "Trademark and Intellectual Property License Agreement and

⁸⁵ 54 TTABVUE 2, 5-8, 13.

⁸⁶ 18 TTABVUE 4.

⁸⁷ 108 TTABVUE 21.

Nondisclosure Agreement” which state, in pertinent part, that Respondent is the owner of five listed trademarks (VAMPIRE FACELIFT, VAMPIRE FACIAL, VAMPIRE BREAST LIFT, O-SHOT, and PRIAPUS SHOT), and provide the conditions under which Petitioner is authorized to use the marks as licensee.⁸⁸ The agreement also includes two provisions stating that the effect of termination is “all rights granted to Licensee hereunder shall revert to Runels, and Licensees shall make no claims to such rights” (Par. 17) and “Licensee agrees [] to immediately discontinue the use of the registered marks, within thirty (30) days after termination” (Par. 18).⁸⁹

The Board, with its jurisdiction limited to trademark registrability, applies contract law as necessary to decide issues properly before it. *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641, 647 (Fed. Cir. 1983); *Vaughn Russell Candy Co. v. Cookies in Bloom, Inc.*, 47 USPQ2d 1635, 1638 n.6 (TTAB 1998). The fundamental objective when interpreting a written contract is to determine the intention of the parties as derived from the language employed in the contract. *Novamedix Ltd. v. NDM Acquisition Corp.*, 166 F.3d 1177, 49 USPQ2d 1613, 1616 (Fed. Cir. 1999). In Respondent’s view, separate from the question of whether the license agreement as a whole warrants application of the doctrine of licensee estoppel, the two termination provisions act as a separate and enforceable contract because “Petitioner specifically agreed to discontinue use of the Five Roy Licensed marks after

⁸⁸ 69 TTABVUE 117-125 (license); 68 TTABVUE 42 (declaration regarding agreement).

⁸⁹ 69 TTABVUE 123.

termination of the license” and so contract estoppel precludes Petitioner from being entitled to a statutory claim involving those marks⁹⁰

Unsurprisingly, Respondent fails to provide any legal support for a reading of a contract that requires ignoring 27 of 29 provisions. Instead, Respondent cites three cases for the general propositions that a plaintiff must prove standing, the former term used to describe entitlement to a statutory claim (*Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998)), and that the Board will enforce agreements that preclude use of a mark (*Australian Therapeutic Supplies Pty Ltd.*, No. 92056381, 56 TTABVUE 4-12, 2016 WL 1659338, at *5 (Mar. 3, 2016) and *Agri-Pro Enterprises of Iowa, Inc. v. Dosatron Int’l*, No. 92043411, 16 TTABVUE 8, 2005 WL 1285676, at *3 (May 3, 2005)).⁹¹ We agree with both propositions, but we will not take two provisions out of a license agreement and construe them as a separate agreement that precludes use of a mark; therefore, we find the second proposition inapplicable here. *Compare Danskin, Inc. v. Dan River, Inc.*, 498 F.2d 1386, 182 USPQ 370, 372 (CCPA 1974) (“Since DANSHEER is not one of the marks appellee agreed not to use (paragraph 11 of the agreement) and appellee is not precluded from

⁹⁰ 108 TTABVUE 21.

⁹¹ 108 TTABVUE 21. Notably, neither case cited for the Board’s enforcement of nonuse contracts involved less than the full agreement. In the *Australian* case cited by Respondent, the parties reached a “gentlemen’s agreement” regarding the use and registration of the NAKED mark in the United States, and in the *AgriPro* case cited by Respondent, the parties reached a settlement agreement which was approved by the district court, whereby one party agreed “to cease and desist from the manufacture, distribution or sale of any medicator apparatus confusingly similar in appearance to Plaintiffs’ medicator apparatus.” We find these cases do not support Respondent’s view that the termination provisions may be enforced without consideration of the license agreement as a whole.

enforcing the settlement agreement, appellee is entitled to a judgment as a matter of law.”). That is, we only will consider the license agreement as a whole; and we reject Respondent’s argument that two provisions allow Respondent to argue that Petitioner is contractually barred from use of the mark, as well as barred by licensee estoppel.

As set forth above, the operative petition to cancel pleads claims of genericness against all registrations except Registration No. 3965320; abandonment based on naked licensing and fraud based on unlawful use against all subject registrations, fraud based on generic use against Registration Nos. 3965319, 4121687, 4131408, and 4402898, and mere descriptiveness against Registration Nos. 4131408 and 4402898. “Where a plaintiff has proven [entitlement to a statutory cause of action] as to at least one properly pleaded ground, it has established [entitlement to a statutory cause of action] for any other legally sufficient ground.” *Int’l Dairy Foods Ass’n v. Interprofession du Gruyère and Syndicat Interprofessionnel du Gruyère*, 2020 USPQ2d 10892, at *9 (TTAB 2020). *Accord Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1728 (Fed. Cir. 2012) (“There is no question that CSI has a personal stake in the outcome of the opposition and has asserted it will be harmed by registration of Triumph’s marks. Therefore, any theory that would prevent Triumph from registering its marks would necessarily prevent the alleged harm to CSI.”).

Petitioner has established the requisite entitlement to a statutory cause of action.

V. LICENSEE ESTOPPEL

In the usual course, we would address an affirmative defense only after addressing the merits of Petitioner's pleaded claims.⁹² However, the doctrine of licensee estoppel, if applicable, is not just a defense; it forecloses consideration of certain claims. *Freeman v. Nat'l Ass'n of Realtors*, 64 USPQ2d 1700, 1703 (TTAB 2002) (attacking validity of marks petitioner was licensed to use "is the type of conduct which the doctrine of licensee estoppel is intended to prevent"). In the interest of judicial efficiency, we first address whether licensee estoppel applies here, and, if so, to which claims.

The license agreement between the parties addressed five registrations (Registration Nos. 3965319, 3965320, 4103302, 4121687, and 4402898). License agreements are a subcategory of contract that allow "one entity to retain ownership of the mark while permitting another separate entity to use the mark subject to control of the first." *Heaton Enterprises of Nevada Inc. v. Lang*, 7 USPQ2d 1842, 1847 (TTAB 1988). Licensee estoppel generally applies in Board proceedings to bar a licensee during the term of the license from challenging the validity of the licensed mark as generic or abandoned through naked licensing. *Freeman v. Nat'l Ass'n of Realtors*, 64 USPQ2d 1700, 1704 (TTAB 2002) (generic claim barred); *Leatherwood Scopes Int'l Inc. v. Leatherwood*, 63 USPQ2d 1699, 1703 (TTAB 2002) (naked

⁹² An affirmative defense is "[a] defendant's assertion raising new facts and arguments that, if true, will defeat the plaintiff's or prosecution's claim, even if all allegations in the complaint are true." *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1720 (TTAB 2008) citing Black's Law Dictionary, p. 430 (7th ed. 1999).

licensing claim barred); *Garri Publ'n Assocs. Inc. v. Dabora Inc.*, 10 USPQ2d 1694, 1697 (TTAB 1988) (naked licensing claim barred).

Licensee estoppel in Board proceedings also bars a licensee, following termination of the license, from challenging the validity of the licensed mark as generic or abandoned through naked licensing on the basis of facts that arose prior to the expiration of the license. *Freeman v. Nat'l Ass'n of Realtors*, 64 USPQ2d at 1703 (“A former licensee, however, may challenge the validity of the licensed mark on facts which arose after the license expired.”); *Estate of Biro v. Bic Corp.*, 18 USPQ2d at 1386 (“Inasmuch as applicant is challenging the agreement based on facts which occurred during the time frame of the ‘license’, we find that applicant is estopped under the doctrine of licensee estoppel.”); *Garri Publ'n Assocs. Inc. v. Dabora Inc.*, 10 USPQ2d at 1697 (“Upon termination of the license, the licensee is no longer hampered by the estoppel to the extent that the licensee is then free to challenge the licensor’s title on the basis of facts which arose after the expiration of the license.”).

A. The Agreement between Petitioner and Respondent

The parties’ March 3, 2016 license agreement specifies that it is governed by the laws of the State of Alabama (Par. 23-24).⁹³ The prefatory language states that Respondent is the owner of five listed trademarks (VAMPIRE FACELIFT, VAMPIRE FACIAL, VAMPIRE BREAST LIFT, O-SHOT, and PRIAPUS SHOT) for a variety of cosmetic medical procedures (the Licensed Marks), and owner of registrations for each of those marks, that Respondent “has orally licensed the Licensed marks” to

⁹³ 69 TTABVUE 123-124.

Petitioner,⁹⁴ and that Respondent and Petitioner desire “a written license to use the Licensed Marks ... and conduct training seminars, classes and workshops regarding the medical procedures associated with the Licensed Marks.”⁹⁵ By the agreement, Respondent grants Petitioner “a limited, revocable, non-exclusive license to use the Licensed Marks” and “to conduct training” regarding the proprietary medical procedures associated with the Licensed Marks in the United States for two years from the effective date “unless otherwise terminated by operation of law or by the acts of the parties in accordance with the terms of this Agreement; provided that [Petitioner] is in good standing and is in compliance with all terms of the Agreement” (preface, Par. 2, 25).⁹⁶

With respect to quality control, the agreement specifies that medical procedures, medical research, and “other information that may be shared with you as part of Runels’ training program in which you participate” are to be treated as confidential information (Par. 1.4); that prices should not fall below stated minimums “to maintain program standards and quality” (Par. 3.7); that Petitioner “agrees to maintain satisfactory standards in respect to the nature of the training materials used to conduct training under this Agreement (Par. 5.8); and upon Respondent’s

⁹⁴ Respondent does not allege any estoppel with respect to any earlier oral license and so we need not address whether such a license existed.

⁹⁵ 69 TTABVUE 117 (preface).

⁹⁶ 69 TTABVUE 117-125. The agreement also provides for payment of fees (Par. 3), reporting obligations (Par. 4), use of the marks (Par. 5), treatment of confidential information (Par. 6-10, 12-13), indemnification and remedies for breach (Par. 14-15), transfer, authority and severability of the agreement (Par. 19-22), that the agreement does not establish a partnership or franchise (Par. 26), and provides for notices, attorney’s fees, and that this is the entire agreement between the parties (Par. 27-29).

request, to furnish for his approval copies of samples of descriptions of services and other items that bear the licensed marks, and modify them if requested (Par. 5.9).⁹⁷

With respect to modification of the agreement, the agreement provides:⁹⁸

11.1 Runels reserves the right at any time to modify this License Agreement and Nondisclosure Agreement and to impose new or additional terms or conditions on your use of his trademark(s) and intellectual property. Such modifications and additional terms and conditions will be effective immediately and incorporated into this Agreement. Your continued use of the trademark(s) and intellectual property will be deemed acceptance thereof. You agree to such updated terms.

11.2 It is agreed that no waiver by either party hereto of any breach of any of the provisions herein set forth shall be deemed a waiver as to any subsequent and/or similar breach.

With respect to termination, the agreement provides:⁹⁹

16.1 Except as otherwise provided, this License Agreement shall terminate automatically at the end of the term specified in section 25.

16.2 This License Agreement and all rights hereby granted may be revoked and terminated at any time by either party without cause on sixty (60) days' written notice to the terminated party.

16.3 Should Licensee fail to comply with any provision of this License Agreement, Runels may terminate this License Agreement on thirty (30) days' written notice; provided, however, that such notice shall be void and of no effect if Licensee corrects such default during the thirty (30) day notice period. However, Runels may immediately terminate this License Agreement if Licensee becomes insolvent, makes an assignment for the benefit of creditors, or has a petition in bankruptcy failed for or against it.

16.4 Termination of this License Agreement and Nondisclosure Agreement shall not impair any accrued rights of Runels.

⁹⁷ 69 TTABVUE 118-120.

⁹⁸ 69 TTABVUE 121.

⁹⁹ 69 TTABVUE 122.

The effect of termination is “all rights granted to Licensee hereunder shall revert to Runels, and Licensees shall make no claims to such rights.” (Par. 17). As to the licensee’s duties upon termination, the agreement provides:

18. Upon termination of this License Agreement, Licensee agrees (1) to immediately discontinue the use of the registered marks, within thirty (30) days after termination, (2) to pay to Runels all License fees accrued to the time of termination, and (3) to deliver to Runels a report of Training Fees due and collected by Licensee from Participating Medical Practitioners and the names and dates of Participating Medical Practitioners receiving training from Licensee according to this Agreement up to the time of termination.

B. Termination of Agreement

At the end of 2016, Petitioner entered into an agreement with a third party to offer training on the procedures under the licensed marks through an educational website for medical professionals.¹⁰⁰ Shortly thereafter, on January 16, 2017, Respondent sent a cease and desist letter to the third party which stated, in part:¹⁰¹

In your case you have had actual knowledge that the trademarks are owned by Charles E. Runels, Jr. because of your teaching agreement with Lisbeth W. Roy, D. O., so your infringement is intentional.

...

If you have not responded to all of the demands made in this letter, including the \$50,000.00 partial compensation demand, by the close of business on Friday, January 20, 2017, Dr. Runels will retain local counsel for trademark infringement litigation against you in United States District Court. Dr. Runels will be awarded injunctive relief, compensatory damages, enhanced damages, disgorgement of your profits from infringing activities and attorney fees under the Lanham Act and applicable state laws in United States District Court. If you do not fully understand Dr. Runels’ demands, then I suggest you speak with your attorney regarding compliance with the demands made in this letter. I do not know of any insurance that would provide you coverage and an attorney in a trademark infringement lawsuit.

¹⁰⁰ 54 TTABVUE 10.

¹⁰¹ 54 TTABVUE 27, 29.

Notwithstanding her belief that the agreement with Petitioner permitted her to offer the disputed teaching program, Petitioner withdrew the program planned with the third party, the references to Respondent's marks were removed from the third-party website, and Petitioner "attempted to appease" Respondent.¹⁰² On February 16, 2017, Respondent sent the following termination letter to Petitioner which stated, in total:¹⁰³

RE: Termination of instructor and licensee status

Be advised that you are no longer an instructor or licensee of the Vampire Facelift®, Vampire Facial®, Vampire Breast Lift®, O-Shot®, and Priapus Shot® trademarks. You have not been charged any trademark licensing fees for February 2017.

Please immediately remove all references to said trademarks from your websites (any website that you own and/or control), your social media accounts (any social media account that you control or in which you have an interest), advertising websites (advertising any business that you control or in which you have an interest), email marketing (used to market any business that you control or in which you have an interest), direct mail marketing (used to market any business that you control or in which you have an interest), advertising brochures (used to market any business that you control or in which you have an interest), etc. so as not to infringe on any of Dr. Runels' registered trademarks.

C. Licensee estoppel

We turn then to Respondent's argument that licensee estoppel bars certain claims. There is no dispute that there was an agreement between the parties that acknowledged Respondent's ownership of five registered marks and provided the conditions under which Petitioner could use the marks as a licensee. There is no dispute that Petitioner used the marks under the license.

¹⁰² 54 TTABVUE 11.

¹⁰³ 54 TTABVUE 11.

For convenience, we reproduce the relevant portion of an earlier chart summarizing the claims pleaded against the five licensed marks:

Registration/Mark	Claims
3965319 VAMPIRE FACELIFT	genericness abandonment based on naked licensing fraud based on unlawful use fraud based on third party generic use
3965320 PRIAPUS SHOT	abandonment based on naked licensing fraud based on unlawful use
4103302 O-SHOT	genericness abandonment based on naked licensing fraud based on unlawful use
4121687 VAMPIRE BREAST LIFT	genericness abandonment based on naked licensing fraud based on third party unlawful use fraud based on generic use
4402898 VAMPIRE FACIAL	genericness mere descriptiveness abandonment based on naked licensing fraud based on unlawful use fraud based on third party generic use

We reject as unfounded Petitioner’s assertion that the agreement did not provide for her use of the licensed marks for the cosmetic medical procedures described in the registrations, but only for teaching services “for which [Respondent] does not have a registered mark.”¹⁰⁴ The agreement is titled “Trademark and Intellectual Property License Agreement and Nondisclosure Agreement” and, as set forth above, the

¹⁰⁴ 109 TTABVUE 6.

provisions combine a licensing agreement for use of the licensed marks and the treatment of confidential information regarding the cosmetic medical procedures to be taught, with detailed financial arrangements relating to both use of the marks for the cosmetic medical procedures and in connection with teaching the cosmetic medical procedures. The “grant of license” is for a license “to use the Licensed Marks ... and to conduct training,” and because the Licensed Marks are defined in the agreement as the marks used for the services listed in the registration, with the registrations listed by mark and registration number, we find the plain meaning of “use the Licensed Marks” is to use the licensed marks in connection with the services for which they are registered.¹⁰⁵ We find that Petitioner was Respondent’s licensee for the purpose of using the five registered marks for the cosmetic medical procedures listed in the registrations for the duration of the license.

We reiterate, licensee estoppel bars certain claims while the license is in force or based on facts that arose during the license. On the first point, Respondent Runels contends that the termination letter of February 16, 2017 provided a sixty-day notice period under the license, and thus the license was in effect on April 4, 2017, the date the petition to cancel was filed.¹⁰⁶ Petitioner counters that the combination of Respondent’s January demand letter to Petitioner’s business partner asserting intentional trademark infringement “because of your teaching agreement with Lisbeth W. Roy, D. O.,” threatening litigation, and demanding compensation, followed

¹⁰⁵ 69 TTABVUE 117-118.

¹⁰⁶ 108 TTABVUE 18.

by the February 16, 2017 termination letter to Petitioner, abruptly terminated her license on February 16, 2017.¹⁰⁷

In consideration of all the circumstances, we find that the license was terminated immediately as a modification of the original agreement. As noted, the agreement provides in Paragraph 16 for two means of termination before the end of the two-year contract term: termination by either party without cause on sixty days written notice, and termination by Respondent on thirty days written notice “[s]hould Licensee fail to comply with any provision of this License Agreement.” Respondent, who drafted both the agreement and the February 16, 2017 termination letter, did not title the letter a “notice of termination,” but as a “termination,” did not state a contractual basis for termination in the letter, and affirmatively stated: “you are no longer an instructor or licensee,” “[y]ou have not been charged any trademark licensing fees for February 2017,” and “[p]lease immediately remove all references to said trademarks.” Respondent does not show how his letter, which does not refer to “notice” in the title and does not provide a sixty day notice period, complies with (or fulfills) the requirement to provide “sixty days written notice.”

Under Alabama law, “parties are free to modify agreements, and if the terms of a subsequent agreement contradict the earlier agreement, the terms of the later agreement prevail.” *Cavalier Mfg., Inc. v. Clarke*, 862 So.2d 634, 641 (Ala. 2003). “Parties to a written contract may by mutual consent without other consideration orally alter, modify or rescind the contract.” *Id.* at 640–41. As shown in the agreement

¹⁰⁷ 109 TTABVUE 6.

between the parties at Par. 11, Respondent was provided extraordinary powers to unilaterally change the contract's terms "at any time" with such modifications "effective immediately and incorporated into this Agreement" and with Petitioner's power limited to "continued use of the trademark(s) and intellectual property will be deemed acceptance thereof. You agree to such updated terms." While Petitioner presumably was not consulted on Respondent's decision to modify how the contract could be terminated, Petitioner's conduct shows acceptance of Respondent's modified terms regarding termination.

Petitioner immediately terminated the agreement to teach, which had prompted Respondent's demand letter to the third party, and unsuccessfully sought to communicate with Respondent. Under these circumstances, where the conduct of both parties clearly followed the modified contractual provisions for termination, with both parties treating the license agreement as having been terminated immediately, we find that the agreement had been modified as to its termination provision, and was not in force six weeks later, when Petitioner filed her April 4, 2017 petition for cancellation.

Nevertheless, in Board proceedings a party who has enjoyed the benefits of the license and has been authorized to use the mark is barred from challenging the validity of the licensed mark on the ground that it is generic or has been abandoned by naked licensing, unless those claims are based on facts that arose after the expiration of the license. *Freeman v. Nat'l Ass'n of Realtors*, 64 USPQ2d at 1704 ("When she was a member of the San Diego Association of Realtors, petitioner

acknowledged the validity of the licensed marks and benefited from the goodwill associated with those marks.”).

Here, the statement of facts in Petitioner’s brief begins “[i]n 2009, new medical technology entered the United States dermatology and aesthetics market ...” and for fourteen pages recounts the rise in the popularity of “vampire” cosmetic procedures based on taking the patient’s blood.¹⁰⁸ Respondent contends that “Petitioner received both the normal benefit of a licensee and a ‘super’ benefit of being paid to train others to perform the trademarked procedures on patients,” and that the facts supporting Petitioner’s allegations arose prior to termination of the license. In her reply brief, Petitioner points out that the petition to cancel alleges that: Respondent’s conduct providing the factual support for the claims “continues;” that Respondent’s testimony and discovery responses constitute facts occurring after termination of the license; and, because the facts are not limited to those which arose during the term of the license, there should be no estoppel.¹⁰⁹

Petitioner’s argument mistakes the rationale behind licensee estoppel. The availability of licensee estoppel does not depend on when the factual support for the pleaded claims ended, but when it began. Licensee estoppel applies when the claims are based on facts available to Petitioner as a licensee of the mark enjoying the goodwill associated with the marks. To avoid licensee estoppel, the factual support

¹⁰⁸ 107 TTABVUE 13-27. We find that, to the extent that Petitioner had reason prior to executing the license to doubt the validity of Respondent’s marks but swallowed those doubts to enter the license acknowledging their validity, Petitioner has waived her right to base claims of the mark’s invalidity on facts arising before the license.

¹⁰⁹ 109 TTABVUE 12-13.

for the claims must arise in the first instance after the termination of the license. *See Freeman v. Nat'l Ass'n of Realtors*, 64 USPQ2d at 1704 (It is clear that petitioner's case of genericness is based on her belief that respondent's collective membership marks were generic from the outset, and remained generic during her twenty-plus years as a dues-paying licensee. ... That is to say, petitioner is not here claiming that these marks became generic after the termination of her license agreement."). Because the facts on which Petitioner relies for all of her claims arose before or during her experience as a licensee, we find that the affirmative defense of licensee estoppel bars Petitioner from bringing her claims of genericness, mere descriptiveness, and abandonment through naked licensing.

Finally, Petitioner contends that equity precludes any application of licensee estoppel here.¹¹⁰ Licensee estoppel has been found inapplicable on equitable grounds to challenges to certification mark licenses and patent licenses. *Lear v. Adkins*, 395 U.S. 653, 670 (1969) ("We are satisfied that *Automatic Radio Manufacturing Co. v. Hazeltine Research, Inc.*, itself the product of a clouded history, should no longer be regarded as sound law with respect to its [] holding [that licensee estoppel was the general rule as to patent cases], and that holding is now overruled."); *Tea Board of India v. The Republic of Tea, Inc.*, 80 USPQ2d 1881, 1884 n.6 (TTAB 2006) ("to the extent opposer is asserting licensee estoppel, such defense does not apply to certification marks"). However, we disagree with Petitioner's argument that the

¹¹⁰ 109 TTABVUE 5, 7-11, 14.

instant facts raise equitable considerations comparable to the considerations relating to certification marks or patents.

As to certification marks, licensee estoppel is inequitable “because of the unique character of a certification mark and the basic difference in concept between a certification mark whose owner is obligated to certify the goods or services of anyone who meets and maintains certain standards and conditions and a trademark used through related companies whereby the trademark owner/licensor may choose the licensees that use its mark.” *Midwest Plastic Fabricators, Inc. v. Underwriters Laboratories, Inc.*, 12 USPQ2d 1267, 1275 n. 6 (TTAB 1989), *aff’d on other grounds*, 15 USPQ2d 1359 (Fed. Cir. 1990). Based on Respondent’s website providing a “list of certified medical providers,” Petitioner asserts “Defendant claims to use the Marks to ‘certify’ the quality of medical Services provided by doctors and nurses all over the world.”¹¹¹ Respondent’s use of “certified” as a synonym for “authorized” to describe licensees allowed to use Respondent’s registered marks in no way holds out Respondent’s marks as certification marks.

As to patents, Petitioner points out that the Supreme Court requires a balancing test for the application of licensee estoppel in patent cases, because the public interest in challenges to invalid patents may outweigh the contract law principle “that forbids a purchaser to repudiate his promises simply because he later becomes dissatisfied with the bargain he has made.” *Lear v. Adkins*, 395 U.S. at 668.¹¹² Petitioner further

¹¹¹ 109 TTABVUE 9.

¹¹² While the Board’s primary reviewing court applies the balancing test of *Lear* in patent cases, the balance may allow application of licensee estoppel. *See Flex-Foot, Inc. v. CRP, Inc.*,

argues that there is an important public interest in Petitioner teaching the cosmetic medical procedures without having “to pay tribute to [a] would be monopolist without need or justification.”¹¹³ We are not convinced by Petitioner’s argument that licensee estoppel should not apply here because of the public interest.

While we agree with Respondent that licensee estoppel bars some claims, we disagree that it bars all claims against the licensed marks. “[A] court remains free to consider the particular circumstances of the case, including the nature of the licensee’s claim and the terms of the license.” 3 J.T. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 18.63 (5th ed., March 2021 update), quoting Restatement Third, Unfair Competition § 33, comment d. With respect to naked licensing, we find that a licensee has access to information about how quality control is exercised under the license—information not readily available to those not licensed. A licensee also may contribute to abandonment of the licensed mark by use that diminishes its trademark significance. Based on these rights under the license, we find it is inequitable to use that otherwise unavailable information or the licensee’s own acts to attack the validity of the licensed mark as abandoned for lack of quality control.

238 F.3d 1362 (Fed. Cir. 2001) (“Based on the clear and unambiguous waiver of future challenges to the validity of the ‘363 patent in the settlement agreement voluntarily entered into by the parties in this case, we hold that Springlite is contractually estopped from challenging the validity of the ‘363 patent and affirm the district court’s judgment in favor of Flex-Foot.”); *Foster v. Hallco Mfg. Co., Inc.*, 947 F.2d 469, 20 USPQ2d 1241 (Fed. Cir. 1991) (“we cannot conclude that the public policy expressed in *Lear* is so overriding that challenges to validity must be allowed when under normal principles of *res judicata* applicable to a consent judgment, such challenge would be precluded”).

¹¹³ 109 TTABVUE 8, quoting *Lear*, 62 USPQ2d at 9.

With respect to genericness, a licensee not only enjoys the goodwill of the licensed mark, but has access to information about how the consumers of the licensed services perceive the licensed mark because those consumers are the licensee's customers, and so the licensee also may contribute to the licensed mark becoming generic by use that diminishes its trademark significance. Based on these rights under the license, we find it is inequitable to use that otherwise unavailable information or the licensee's own acts to attack the validity of the licensed mark as generic.

Because generic and merely descriptive marks suffer from the same deficiencies to different degrees, we find the claims of genericness and mere descriptiveness are related for the purposes of applying licensee estoppel. Generic and merely descriptive terms are adjacent at the end of "an ascending order [of proposed marks] which roughly reflects their eligibility for trademark status and the degree of protection accorded." *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d. 965, 128 USPQ2d 1370, 1373 (Fed. Cir. 2018) (citations omitted). A generic mark is "the ultimate in descriptiveness." *Id.* at 1373 n.3. Claims of genericness and mere descriptiveness both depend on facts regarding public perception of the licensed mark, and whether the mark names the goods or immediately conveys information about the goods. Based on the close relationship to the claim of genericness, we find licensee estoppel also should bar the claim of mere descriptiveness.

In contrast, we find no reason to bar claims that a registration was fraudulently procured, particularly where, as here, the marks were only licensed following registration. There is no nexus between the licensee and the fraudulent conduct that

resulted in issuance of the registration, and so we see no inequity in allowing a licensee to attack the licensed mark as fraudulently procured. This is a different scenario from one in which the licensee, by virtue of the license, has access to information about and the ability to contribute to diminution of the licensed mark's trademark significance. To the degree that the licensee nonetheless enjoyed the benefits of the fraudulent registration, the licensee also ran an unknowing risk of being associated with fraudulent conduct in which the licensee took no part. Finally, we note that Respondent cites no Board precedent – and we are aware of none – in which licensee estoppel barred a claim that the licensed mark was fraudulently procured. *Freeman v. Nat'l Ass'n of Realtors*, 64 USPQ2d 1700 (TTAB 2002) (generic claim barred); *Leatherwood Scopes Int'l Inc. v. Leatherwood*, 63 USPQ2d 1699 (TTAB 2002) (naked licensing claim barred); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991) (naked licensing claim barred); *Garri Publ'n Assocs. Inc. v. Dabora Inc.*, 10 USPQ2d 1694, 1697 (TTAB 1988) (naked licensing claim barred).

In sum, we find that the affirmative defense of licensee estoppel bars the claims of genericness and naked licensing brought against the licensed marks VAMPIRE FACELIFT (Registration No. 3965319); O-SHOT (Registration No. 4103302); VAMPIRE BREAST LIFT (Registration No. 4121687); and VAMPIRE FACIAL (Registration No. 4402898) and the claim of naked licensing brought against the licensed mark PRIAPUS SHOT (Registration No. 3965320). In addition, we find that licensee estoppel bars the claim of mere descriptiveness brought against the licensed mark VAMPIRE FACIAL. We further find that the two claims of fraud, based on

unlawful use and knowledge of generic or merely descriptive use, are not barred, but will be addressed on the merits.

VI. ABANDONMENT VIA NAKED LICENSING

Petitioner claims that Respondent Runels abandoned all the subject registered marks through naked licensing.¹¹⁴ Licensee estoppel bars Petitioner from bringing this claim against the five registrations Petitioner was licensed to use, so we address the claim with respect to unlicensed Registration Nos. 4131408 (VAMPIRE NIPPLE LIFT) and 4100383 (ORGASM SHOT).

In support of her abandonment claim based on naked licensing, Petitioner asserts that the registered services are “offered to consumer-patients across the United States with great variation, because Defendant has never attempted to set consistent standards,” that the licenses “do not regulate in any way how the licensees are required or allowed to use the Marks in commerce,” and that “Licensees have no relationship with Defendant apart from paying him a monthly fee to use the Marks to advertise and sell their own professional services in connection with their own, private practices.”¹¹⁵

Under Trademark Act Sec. 45(2), a mark shall be “abandoned”:

When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark. Purchaser motivation shall not be a test for determining abandonment under this paragraph. 15 U.S.C. 1127(2).

¹¹⁴ 107 TTABVUE 45-48.

¹¹⁵ 107 TTABVUE 47.

Uncontrolled, or naked, licensing is a form of owner conduct that may result in the loss of trademark significance. “It is well settled that uncontrolled licensing of a mark by the owner thereof results in abandonment of that mark because allowing other parties to use the mark, without inspection and supervision to assure the maintenance of the quality which the name has come to represent, causes that name to lose its significance as a mark.” *Heaton Enterprises of Nevada Inc. v. Lang*, 7 USPQ2d at 1847. “A licensor may license his mark if the licensing agreement provides for adequate control by the licensor over the quality of goods or services produced under the mark by a licensee. The purpose of such a requirement is to protect the public from being misled. Uncontrolled licensing of a mark results in abandonment of the mark by the licensor.” *Haymaker Sports, Inc. v. Turian*, 581 F.2d 257, 198 USPQ 610, 613 (CCPA 1978) (citations omitted). Because finding a “naked license” signals involuntary trademark abandonment and forfeits protection, Petitioner must meet “a stringent standard.” *Taco Cabana Int’l, Inc., v. Two Pesos Inc.*, 932 F.2d 1113, 19 USPQ2d 1253, 1259 (5th Cir. 1991), *aff’d*, 505 U.S. 763, 23 USPQ2d 1081 (1993).

Whether a trademark owner has provided for appropriate quality control to accompany use of the mark depends on the circumstances surrounding the use. *Id.* (“Where the particular circumstances of the licensing arrangement persuade us that the public will not be deceived, we need not elevate form over substance and require the same policing rigor appropriate to more formal licensing and franchising transactions.”). A licensor need not show that its quality control efforts are comprehensive or extensive. *Woodstock’s Enterprises Inc. (California) v. Woodstock’s*

Enterprises Inc. (Oregon), 43 USPQ2d 1440, 1446 (TTAB 1997), *aff'd*, No. 97-1580 (Fed. Cir. Mar. 5, 1998). A formal arrangement for policing the quality of the goods sold by the licensee under the mark is not necessary. *Id.* at 1446; *Sock It To Me, Inc. v. Aiping Fan*, 2020 USPQ2d 10611, *5 (TTAB 2020).

The sufficiency of the quality control is not measured in the abstract, and it is difficult to prove naked licensing where there is small or little evidence of any quality issues. *Taco Cabana Int'l Inc., v. Two Pesos Inc.*, 19 USPQ2d at 1259 (“The purpose of the quality-control requirement is to prevent the public deception that would ensue from variant quality standards under the same mark or dress.”); *Stockpot, Inc. v. Stock Pot Rest., Inc.*, 220 USPQ 52, 59 (TTAB 1983), *aff'd*, 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) (“[T]he inference of abandonment is not drawn because satisfactory quality was maintained and, hence, no deception of purchasers occurred.”). Finally, control may be adequate where the licensor justifiably relies on the integrity of the licensee to ensure the consistent quality of the services performed under the mark (*Taco Cabana Int'l Inc. v. Two Pesos Inc.*, 19 USPQ2d at 1259), or otherwise exercises reasonable control under the circumstances of the case (*Midwest Plastic Fabricators v. Underwriters Lab.*, 906 F.2d 1568, 15 USPQ2d 1359, 1363 (Fed. Cir. 1990)). *Accord Sock It To Me, Inc. v. Aiping Fan*, 2020 USPQ2d at *5 (“Here, Applicant has established quality control over the source of manufacturing and type of fabrics used to make socks bearing the mark, and her daughter-in-law inspects the goods to ensure that they consistently comply with these standards.”); *Color Key Corp. v. Color Assocs., Inc.*, 219 USPQ 936, 942 (TTAB 1983) (“nor would it be

unreasonable to anticipate and sanction a large amount of substantially independent performance on the part of licensees whose initial training had been deemed thorough and who had passed muster as apprentices.”).

With respect to how Respondent ensures the quality of cosmetic medicine procedures offered under the licensed marks, Respondent testified “[p]rior to September 25, 2015, I personally administered the licensing of all of my trademarks.”¹¹⁶ Respondent specifically relied on state licensing of healthcare professionals, information usually available online, as a prerequisite to becoming a licensee. “Since the very beginning,” Respondent or his employees confirmed that “potential licensees have appropriate previous training or licensing that would enable them to perform the services offered under my registered marks.” Respondent refused licenses to those who did not have the appropriate licensing or training.¹¹⁷

As an example of confirmation of previous training, Respondent would accept a potential licensee if licensed as an “intensive care nurse or family practitioner” because that potential licensee has “an understanding of anatomy” and “experience with placing a foley catheter or doing a pelvic exam” that would “allow understanding of the O SHOT procedure” which the O SHOT registration describes as injecting “Gspot, clitoris, and/or other vaginal structures.”¹¹⁸ Depending on the requirements of the state of licensure, medical professionals other than medical doctors or doctors

¹¹⁶ 49 TTABVUE 107.

¹¹⁷ 47 TTABVUE 56-58; 49 TTABVUE 104-105, 64 TTABVUE 29-30.

¹¹⁸ 47 TTABVUE 61.

of osteopathy may be required to have a medical doctor or doctor of osteopathy listed on their application as a supervisor.¹¹⁹ Respondent and his employees, if not familiar with state license requirements for administering injections, call the state nursing and medical boards to ask.¹²⁰ With respect to training in lieu of licensing, Respondent would accept a potential licensee if they had an Allergan company account to administer the filler Juvederm because “PRP is itself a filler with a much safer side-effect profile than Juvederm... .”¹²¹ During the period early after his registrations issued, the licensee would discuss the procedures with Respondent and “[t]his discussion functioned like an oral exam and teaching simultaneously.”¹²² During that period, there was no written license between Respondent and his licensees.¹²³ Respondent testified that during these early years of use, he orally tested licensees on the content of his training, and required licensees to follow his protocols, which also were unwritten, and enforcement “was not difficult to do in these early years, as for the first few years I had only a small number of new licensees, so I was able to and did have extensive communication with each of them concerning my protocols and quality control.”¹²⁴

¹¹⁹ 47 TTABVUE 61.

¹²⁰ 49 TTABVUE 58.

¹²¹ 49 TTABVUE 64, TTABVUE 29-30.

¹²² 47 TTABVUE 57.

¹²³ The record does not identify any specific oral licensee from that period except Petitioner.

¹²⁴ 64 TTABVUE 28.

On September 25, 2015, Respondent testified, he created the American Cosmetic Cellular Medicine Association (ACCMA) to act as his licensing agent.¹²⁵ At that time Respondent began requiring licensees to “click through” on his website an online license agreement with six numbered headings which the licensee executed by clicking “I agree.”¹²⁶ The Licensee’s “Rights and Obligations” stated (quality control provision in **bold**):¹²⁷

Your rights and obligations under this License Agreement with respect to the use of these Trademark(s) are as follows.

During the Licensing Period:

You may use the Trademark(s) for so long as You pay the Licensing Fee(s) and **follow accepted ACCMA protocols**; and

You will be listed as a licensed provider on the ACCMA website.

You understand and agree to the following:

that You may not teach the trademarked procedures;

that if You quit paying the Licensing Fee(s) and continue to use the Trademark(s), You will pay ACCMA \$50,000 per infringement;

that You will pay ACCMA \$50,000.00 as liquidated damages for Your infringement on the Trademark(s); and,

that You will pay all costs of litigation, including attorney’s fees and court costs, for Your infringement on the Trademark(s).

Once confirmed by Respondent (or his employees) as possessing previous licensing or training, the potential licensee receives access to online training materials, including videos, written instructions, and vendors for FDA approved supplies, and an orientation with Respondent or an employee of Respondent “dedicated to familiarizing them with my membership website and content.”¹²⁸ The

¹²⁵ 64 TTABVUE 28-29.

¹²⁶ 56 TTABVUE 2-3, 64 TTABVUE 32-33; 220-221. The headings describe the license, rights and obligations, modifications, applicable law, venue, and integration.

¹²⁷ 64 TTAB 220-221.

¹²⁸ 47 TTABVUE 57; 64 TTABVUE 31-32.

online training “could only be purchased through the CMA’s websites or over the phone with a CMA employee,” and provided “multiple, detailed instructional videos and updated videos on the various licensed procedures” only accessible via a private, password-protected licensee-member website.¹²⁹

Respondent trained educators, who were medical doctors or doctors of osteopathy and had been providing the procedures for at least six months, to offer “hands on” classes in the procedures to potential licensees, to seek the confirmation of previous licensing, and to sign a form attesting as to whether the potential licensees demonstrated an understanding of the procedure in the class. The potential licensee then could enroll in the membership site and receive the orientation as to how to navigate it.¹³⁰ Those who did not fulfill the requirements of hands-on training were refunded their money and not offered a license.¹³¹

Once the training was completed, either by completing the online training sequence or by Respondent or an educator forwarding their application following the hands on training, the licensee was added to the directory for the procedure they were trained in, and shipped certificates. Thereafter, via either the online training or when they signed the application at the hands on training, licensees agreed to pay for the license, the directory listing, and access to the website and trademarks.¹³² In order to perform the procedures on completion of training, licensees also must agree to use

¹²⁹ 47 TTABVUE 57.

¹³⁰ 47 TTABVUE 57, 62.

¹³¹ 47 TTABVUE 57.

¹³² 47 TTABVUE 58-59.

FDA-approved devices, adhere to Respondent's minimum prices, and keep Respondent's "information, protocols, and website materials" confidential. Licensees may not themselves teach any procedure.¹³³

If a patient makes a negative report to Respondent regarding a procedure, Respondent calls the licensee who performed the procedure to review the procedure and provide any necessary correction.¹³⁴ As a rule, Respondent finds the discussion and review are sufficient, and takes no further action.¹³⁵ If the licensee refuses to perform the procedure as Respondent specifies, the license could be terminated.¹³⁶

There is no dispute that, at most, Respondent exercises quality control at the beginning of the license by screening licensees, and in the event of a quality problem brought to his attention. Respondent does not meet his licensees or require his licensees to meet educators, conduct on-site visits, require use of any specific equipment prior to entering the license, require any reports regarding use of the licensed mark(s) or participation in any online training once the license issues.¹³⁷ Information to ensure quality is available to licensees from Respondent's website, email links, or from Respondent on a voluntary basis.¹³⁸ In addition to the videos available on the membership site for licensees, licensees may seek, also on a

¹³³ 47 TTABVUE 11-12, 61.

¹³⁴ 47 TTABVUE 63, 49 TTABVUE 200-201, 64 TTABVUE 30-31.

¹³⁵ 49 TTABVUE 200-201, 64 TTABVUE 30-31.

¹³⁶ 64 TTABVUE 31.

¹³⁷ 18 TTABVUE 18.

¹³⁸ 64 TTABVUE 30.

voluntary basis, information to ensure quality in conversations with Respondent to confirm and help further their understanding of the procedures offered under the registered marks; and through a weekly webinar, or transcriptions of the webinars which are posted to the membership sites.¹³⁹

Petitioner has failed to establish that Respondent's quality control measures are insufficient in the context of cosmetic medicine practices. Respondent plainly relies on existing state licensing requirements for health care professionals for the bulk of his quality control measures, but there is nothing in the record suggesting that qualified health professionals who are trained in a specific procedure then require supervision as they perform the procedure. More specifically, Petitioner offers no evidence on the general standards for performance of cosmetic medicine procedures, or the standards for quality control in other medical procedure licenses. Petitioner merely invites the Board to adopt Petitioner's view of what she perceives as defects in quality control.

Because the cases relied upon by Petitioner involve unrelated goods and services, we reject Petitioner's argument that Respondent's quality control procedures "are beyond the pale" compared to other cases in which abandonment by naked licensing was found.¹⁴⁰ Petitioner provides no explanation, and we can think of none, why

¹³⁹ 64 TTABVUE 30.

¹⁴⁰ 107 TTABVUE 45-46, citing *Eva's Bridal Salon Ltd. v. Halanick Enterprises, Inc.*, 2011 U.S. App. LEXIS 9539 (7th Cir. 2011) (bridal shop); *Freecycle Sunnyvale v. Freecycle Network*, 626 F.3d 509, 97 USPQ2d 1127 (9th Cir. 2010) (recycling services); *Barcamerica Int'l USA Trust v. Tyfield Imps., Inc.*, 289 F.3d 589, 62 USPQ2d 1673 (9th Cir. 2002) (wine); *John C. Flood of Va., Inc. v. John C. Flood, Inc.*, 700 F.Supp.2d 90 (D.D.C. 2010) (plumbing services); *Kebab Gyros, Inc. v. Riyad*, 2009 WL 5170194 (M.D. Tenn. 2009) (restaurant services); *Westco Group, Inc. v. K.B. & Assocs.*, 128 F. Supp. 2d 1082, 58 U.S.P.Q.2d 1068 (N.D. Ohio 2001)

quality control measures found insufficient in connection with trademark licenses for various unrelated goods and services should be found insufficient in this case, which involves trademark licenses for cosmetic medicine services. There is no single bright line as to what constitutes sufficient quality control measures, and it is Petitioner's burden to establish what constitutes adequate quality control in the cosmetic medicine field. This Petitioner failed to do, and therefore the claim that Respondent abandoned his registered marks through naked licensing also must fail.

The petition to cancel Registration Nos. 4131408 (VAMPIRE NIPPLE LIFT) and 4100383 (ORGASM SHOT) as abandoned by Respondent's naked licensing is denied.

VII. GENERICNESS

We address the genericness claim as to unlicensed Registration Nos. 4131408 (VAMPIRE NIPPLE LIFT) and 4100383 (ORGASM SHOT).¹⁴¹

Generic terms are "by definition incapable of indicating source," and so "are the antithesis of trademarks, and can never attain trademark status." *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1142 (Fed. Cir. 1987). "To allow trademark protection for generic terms, i.e., names which describe

(retail mattress stores); *R. C. W. Supervisor, Inc. v. Cuban Tobacco Co.*, 220 F. Supp. 453, 138 U.S.P.Q. 441 (S.D.N.Y. 1963) (cigars); *In Midwest Fur Producers Ass'n. v. Mutation Mink Breeders Ass'n.*, 127 F. Supp. 217, 103 U.S.P.Q. 389 (D. Wis. 1954) (mink pelts and coats).

¹⁴¹ We reiterate, Petitioner pleads genericness against all subject registrations except Registration No. 3965320 (PRIAPUS SHOT), and pleads mere descriptiveness against Registration Nos. 4131408 (VAMPIRE NIPPLE LIFT) and 4402898 (VAMPIRE FACIAL). Licensee estoppel bars Petitioner from bringing the genericness claim against the five registrations Petitioner was licensed to use, namely Registration Nos. 3965319, 3965320, 4103302, 4121687, and 4402898. Licensee estoppel also bars Petitioner from bringing the claim of mere descriptiveness against Registration No. 4402898 (VAMPIRE FACIAL).

the genus of goods being sold, even when these have become identified with a first user, would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are.” *Id.* (citation omitted).

“Determining whether a mark is generic ... involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?” *H. Marvin Ginn Corp.*, 228 USPQ at 530; *In re Virtual Independent Paralegals, LLC*, 2019 USPQ2d 111512, *2 (TTAB 2019).

A. Genus of Services

Because the identification of goods or services in an application defines the scope of rights that will be accorded the owner of any resulting registration, as a rule “a proper genericness inquiry focuses on the description of services set forth in the certificate of registration.” *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991). In this case, we find that the relevant genus of services is commensurate with the recitation of services:¹⁴²

VAMPIRE NIPPLE LIFT	non-invasive cosmetic medical procedure, namely, isolation and injection of blood-derived growth factors, including but not exclusive to platelet rich plasma, for the correction of inverted nipples
ORGASM SHOT	non-invasive cosmetic medical procedure namely, the injection of blood-derived growth factors including platelet rich fibrin matrix within the Gspot, clitoris,and/or other vaginal structures to rejuvenate the tissue and facilitate the female orgasm

¹⁴² Respondent does not argue for a different definition of genus, and refers to “the genus of services identified in the respective registrations.” 108 TTABVUE 14.

B. Relevant Public's Understanding of the Term

The relevant public for a genericness determination is the purchasing or consuming public for the identified goods or services. *Magic Wand Inc. v. RDB Inc.*, 19 USPQ2d at 1553; *In re Haden*, 2019 USPQ2d 467424, *2 (TTAB 2019). Here, the relevant public consists of the general public who may elect to undergo, or medical professionals who administer, cosmetic medical procedures featuring injection of platelet rich plasma.¹⁴³ A term may be generic for a genus of goods or services if the relevant public understands the term to refer to a key aspect of that genus. *See Royal Crown Co. v. Coca-Cola Co.*, 892 F.3d 1358, 127 USPQ2d 1041, 1047 (Fed. Cir. 2018) (“On remand, accordingly, the Board must examine whether the term ZERO, when appended to a beverage mark, refers to a key aspect of the genus.”).

Evidence of the relevant public's understanding of the designation may be obtained from any competent source. *In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1634 (Fed. Cir. 2016). Competent sources may include purchaser testimony, consumer surveys, dictionaries, trade journals, newspapers, and other publications. *In re Merrill Lynch, Fenner, and Smith*, 4 USPQ2d at 1143; *In re Virtual Independent Paralegals, LLC*, 2019 USPQ2d 111512, at *2. Registrant's own specimens and promotional materials are competent sources to show genericness. *See*

¹⁴³As set forth earlier, platelet rich fibrin matrix is activated PRP, and so “PRP injections” broadly describes the services for both the VAMPIRE NIPPLE LIFT and ORGASM SHOT marks.

In re Gould Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987); *In re Mecca Grade Growers, LLC*, 125 USPQ2d 1950, 1958 (TTAB 2018).

1. **VAMPIRE NIPPLE LIFT**

Registration No. 4131408 for the mark VAMPIRE NIPPLE LIFT issued, with a disclaimer of NIPPLE LIFT, for “non-invasive cosmetic medical procedure, namely, isolation and injection of blood-derived growth factors, including but not exclusive to platelet rich plasma, for the correction of inverted nipples.”

We turn first to the term NIPPLE LIFT. A disclaimer of a component of a mark indicates that the component is unregistrable, but does not indicate whether the term is unregistrable as merely descriptive or generic. *See* Trademark Act Section 6(a), 15 U.S.C. 1056(a) (“The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable.”). We address the degree of descriptiveness of the disclaimed term. With respect to the term NIPPLE LIFT, we take judicial notice that the term “lift” is defined as “plastic surgery on a part of the body typically to improve a drooping or sagging appearance especially by reducing excess skin and fat” and that the term “nipple” appears in the recitation of services as the object of Respondent’s cosmetic medical procedures.¹⁴⁴ As set forth above, both dictionary definitions and the identification of goods may serve as evidence that a term is generic. *In re Merrill Lynch, Fenner, and Smith*, 4 USPQ2d at 1143 (dictionary); *In re Johanna Farms, Inc.*, 222 USPQ at 609 (identification). We find

¹⁴⁴ Merriam-Webster.com Dictionary, <https://www.merriam-webster.com/dictionary/lift>. Accessed 25 Aug. 2021.

the term NIPPLE LIFT is generic when used in connection with cosmetic medicine procedures for correction of inverted nipples.

We turn to whether the term VAMPIRE, when used with protein rich plasma or PRP injections for cosmetic medicine applications, refers to a key aspect of the genus. The term “vampire” is defined as “the reanimated body of a dead person believed to come from the grave at night and suck the blood of persons asleep.”¹⁴⁵ The reference to the fictional “vampire” denotes the extraction of the patient’s blood, the procedure with which each PRP injection begins. The record shows that, about 2010 with the introduction of the centrifuge technology for use of PRP in cosmetic applications, the media quickly adopted “vampire” to name the new application of PRP in cosmetic medicine:

On July 14, 2010, AOLHealth.com posted:¹⁴⁶

“Vampire Facelift” Fights Wrinkles “True Blood” Style

In the “Twilight” of your youth, you might look to a new trend in cosmetic surgery dubbed the “**vampire** facelift” that involves getting an injection of your own blood. ... It’s another kind of cosmetic filler but instead of getting a shot of chemicals, patients are injected with a mixture of their blood, called Selphyl.

On July 15, 2010, CBSNews.com posted:¹⁴⁷

The Vampire “Facelift”: Twilight for Your Face

A new cosmetic procedure may just “eclipse” its competition. They’re calling it the “**Vampire** Facelift. It’s not really a facelift, though, it’s an injectable filler called Selphyl (get it? Sounds like cell-fill). ... But unlike the competition, Selphyl uses the patient’s own blood to do the plumping. Twilight enough for ya?

¹⁴⁵ Merriam-Webster.com Dictionary, <https://www.merriam-webster.com/dictionary/vampire>. Accessed 25 Sept. 2021.

¹⁴⁶ 48 TTABVUE 31-32.

¹⁴⁷ 48 TTABVUE 15-16.

On December 13, 2010, the website Zerona Laser Treatment posted:¹⁴⁸

Vampire facelift costs and results

Vampire facelift is a new type of face rejuvenation that is used to fill in wrinkles and facial lines for your face. This is a new technique that is developed by the company called Selphyl. Unlike other facial rejuvenation treatments, **vampire** facelift uses blood from the own patient to fill in the lines and wrinkles of the patient. This is why this new liquid filler is called **vampire** facelift.

On January 11, 2011, laserliposuctiontips.com posted:¹⁴⁹

Vampire facelift cost

If you want to know how much does a **vampire** facelift cost, this article will give you a list of pricing for some of the different cities in the US. ... For those who might not know how this **vampire** facelift procedure works, it is actually quite similar to current facelift treatments. Basically, surgeon will inject fillers into the patient's face except that the surgeon will "draw the patient's blood, then separate the platelets from the blood and inject those collagen-activating platelets into problem areas of the skin."

On February 10, 2011, EmpowHER.com posted:¹⁵⁰

Vampire Facelift--What is it and Does it Work?

Most branded facelifts include a benefit, or "hook," for the consumer in their name: the Weekend Facelift, the Lifestyle Lift, the Quick Lift. But one branded rejuvenation option uses a different approach altogether, calling itself the Selphyl® **Vampire** Facelift. ... According to the manufacturer's website, www.selphyl.com, Selphyl technology allows a physician to use components of a patient's own blood to create what's termed "Platelet-rich Fibrin Matrix."

On February 17, 2011, TheDenverChannel.com reported:¹⁵¹

Mix pop culture with plastic surgery and you get what's now being called "The **Vampire** Facelift." Esther Marlow recently lost almost 70 pounds. "Because of my weight loss, I've had a lot of loose skin here on my face," said Marlow. So the 50-year-old Highland Ranch "Twilight" fan now wants a "**Vampire**

¹⁴⁸ 48 TTABVUE 17.

¹⁴⁹ 48 TTABVUE 28.

¹⁵⁰ 48 TTABVUE 23-25. Respondent posted a comment to this website identifying himself as "Designer of the Vampire Facelift™."

¹⁵¹ 48 TTABVUE 19.

Facelift.” ... But she’ll have to lose a little blood first.just another weapon in the process of trying to cut back the years without going under the knife.”

On February 17, 2011, Cosmetic Surgery Today posted on their website:¹⁵²

Vampire Facelift - Sounds creepy cool, but what are the benefits?

To set the record straight, a **vampire** face lift-at least the kind of face lift that uses Selphyl injectable filler- does not make you look like a vampire. ... Selphyl injectable filler is a dermal filler system that uses the patient’s own blood as the filler.

On March 2, 2011, the New York Times published the article excerpted below:¹⁵³

‘Vampire Face-Lifts’: Smooth at First Bite

In this anti-aging age, perhaps it’s unsurprising that vampires - ancient, but with forever- young skin - are a cultural obsession. Now a cosmetic treatment to fill in wrinkles or to plump up hollow cheeks is being marketed as a “**vampire** filler” or a “vampire face-lift.” ... Selphyl, as the system is called, arrived on the booming facial-rejuvenation market in 2009, and is now used by roughly 300 doctors nationwide in the name of beauty, said Sanjay Batra, the chief executive of Aesthetic Factors, which manufactures the Selphyl system. This year, the “**vampire** face-lift” has been promoted on “The Rachael Ray Show” and “The Doctors.” It’s also gotten air time on more than a dozen local news programs, some of which presented unproved claims that results will last two years.

But Dr. Charles Runels, a cosmetic doctor in Fairhope, Ala., liked the term so much he trademarked it. Dr. Runels, who used to be a board-certified internist, said this was to standardize the offering so patients know what to expect. His **vampire** face-lift entails first volumizing the face with Juvederm, a hyaluronic acid filler that lasts up to a year, then ‘using Selphyl to polish off under the eyes, and thinner-skin areas,” he said. Now any doctors who want to promote the **vampire** face-lift must pay Dr. Runels \$47 a month to follow his protocol, posted online. (So far, 10 have signed up.) Asked what he intends to do about all the doctors already using **vampire** face-lifts, he said, “I don’t know how I’m going to rein it back in but I will.”

¹⁵² 48 TTABVUE 20-21.

¹⁵³ 50 TTABVUE 56-59.

In his response to interrogatories, Respondent responded “no” when asked if he contended that “it was your original idea to use the word Vampire in connection with the PRFM Method;” he also responded “no” when asked if he contended that he “had never heard the word Vampire used in connection with the PRFM Method before the First Application Date.”¹⁵⁴ In his response to requests for admission, Respondent admitted that he was aware that the word “vampire” had been used “to describe PRP therapy applied to the face prior to April 20, 2010,” Respondent’s alleged date of first use of VAMPIRE FACELIFT.¹⁵⁵

In addition to his admissions in this proceeding, we find Respondent’s statements when he first began use of “vampire” in connection with PRP injections acknowledged the existing link between the term “vampire” and PRP injections. On July 20, 2010, Respondent commented on a third party blog:¹⁵⁶

Glad to hear that you’re talking some about the **vampire**. Just a few notes that you may find interesting. The company that makes the **vampire** facelift actually prefers that the real name, Selphyl, be used. I’m a physician who does the **vampire** for people and I don’t use the name Selphyl much [...]

On August 10, 2010, in an email to a reporter, Respondent stated in part:¹⁵⁷

As for the **Vampire**. It had been called the **vampire** filler, but I was the first to use the term **Vampire** Facelift and am one of the leaders in developing uses for this amazing process.

...

If you google **Vampire** Facelift (which I’m sure you’ve already done), you will see how many stations have tied in the **Vampire** Facelift with the current

¹⁵⁴ 47 TTABVUE 51.

¹⁵⁵ 47 TTABVUE 8.

¹⁵⁶ 72 TTABVUE 436.

¹⁵⁷ 72 TTABVUE 330.

vampire movie craze (though many of the stations got the fact about the procedure a little confused).

On August 26, 2010, WEARTV.com posted:¹⁵⁸

GULF COAST - Its called the “**Vampire** Facelift” and its’ results are remarkable. Even better, a Gulf Coast doctor is one of the first in the country to perform the revolutionary procedure. ... Doctor Charles Runels is one of the first physicians in the country to perform the “**Vampire** Facelift”. ... He dubbed it the **Vampire** Facelift, because he extracts and uses the patients’ own blood for the procedure.

In an undated interview in Cosmetic Surgery Today with a copyright year of 2013,

Respondent acknowledged third party use of “vampire facelift” as the name of the

PRP injection:¹⁵⁹

Let me ask you a question about the Vampire Facelift.TM We’ve heard so many people talking about it all over the country, were these people trained by you? Some were, some were not. ... I thought I need to use this as part of a trade secret or the way that I’m thinking about the face, combining Leonardo all the way up to present computer analysis of the face and what makes it beautiful. ... I deemed the procedure the Vampire Facelift.TM Unfortunately, just like with Roller Blades, the press picked it up, and some physicians thought it was synonymous with using growth factors in the face and got reported that way. The New York Times covered the story, the Doctors show covered the story, Kelly and Regis...it's been all over. Sometimes they got it right and sometimes they didn't, which is a common problem with the trademark. But, I was the first to use it, I defined it.

Based on this evidence, we find that the first public perception of the term “vampire” when used in connection with PRP cosmetic injections was shaped by the national media and physicians who referred to “vampire” fillers or facelifts when reporting the introduction of the PRP centrifuge by Aesthetic Factors LLC or

¹⁵⁸ 64 TTABVUE 151-152.

¹⁵⁹ 49 TTABVUE 120-121, 50-51.

discussing the use of PRP cosmetic injections.¹⁶⁰ We further find that these first published uses of “vampire” in connection with new cosmetic procedures featuring PRP injections had no connection to Respondent, or a connection limited to acknowledging Respondent as a provider of cosmetic medicine procedures who expanded his practice to offer the new cosmetic procedures featuring PRP injections. In addition, we find that Respondent’s own public statements at the time were consistent with use of “vampire” as the name of the new PRP injections for use in cosmetic medicine applications.

Following the introduction of the “vampire” technology in cosmetic medicine applications, the record shows “vampire” PRP cosmetic injections next came to national public attention with the 2013 VAMPIRE FACIAL procedure publicly performed on Kim Kardashian by third party Dr. Julian Gallo. It is undisputed that the procedure brought wide attention to “vampire” procedures, both the VAMPIRE FACIAL and the VAMPIRE FACELIFT, as the procedure was first incorrectly identified. It also is undisputed that Respondent was not directly associated with either the viral Instagram post with Ms. Kardashian’s picture of her face covered in blood or the television show which aired the procedure being performed by Dr. Gallo. We find that the use of “vampire” in connection with the Kardashian procedure

¹⁶⁰ We reject Respondent’s current position dismissing the evidence as “a few random internet articles/advertisements.” 108 TTABVUE 34. While it is true that some of the uses listed above were published on “specialty” websites devoted to cosmetic medicine with an unknown number of visitors, the presence of online articles from the New York Times and CBS news is sufficient to support our finding of public perception via exposure to “national media.”

named the PRP cosmetic injection (or more accurately, microneedling) performed and not the source of the procedure.

We address whether Respondent altered the public perception that Kim Kardashian's VAMPIRE FACIAL named the PRP cosmetic procedure, and not the source, by claiming Dr. Gallo was a licensee (and so the use of "vampire" by Dr. Gallo's patient inured to Respondent's benefit), and posting the Kardashian picture as a focal point of his marketing. Respondent's claim of a license is based on the purchase of the Eclipse centrifuge by Dr. Gallo; Dr. Gallo once logging into Respondent's website; and the agreement between Respondent and Eclipse Aesthetics, LLC in effect at that time which granted Eclipse Aesthetics, LLC an exclusive license and the ability to "sub-license" the VAMPIRE FACELIFT mark to purchasers of its PRP centrifuge system for cosmetic applications.¹⁶¹ The record includes an Eclipse invoice to Dr. Gallo for the December 10, 2012 purchase of a centrifuge, and the body of the invoice includes, as shown below, a "license" included at no charge:

¹⁶¹ 108 TTABVUE 49. Respondent no longer advertises the VAMPIRE FACIAL as the procedure performed on Ms. Kardashian by a licensee. The record includes the March 4, 2020 district court order, in an action brought by Ms. Kardashian against Respondent, that Respondent is permanently enjoined from exhibiting or using Ms. Kardashian's photograph, name, image or likeness to promote his goods or services, pursuant to the parties' stipulated judgment and permanent injunction. *Kimsaprincess Inc. et al v. Charles Runels et al.*, Case No. 2:19CV10415 (C.D. Cal.). 100 TTABVUE 25-28.

Purchase Order	Ship Via	FOB	Reference	Entered By	Sales rep	Terms
	UPS Ground	Ship point		MR 12/10/2012 3FL2		C.O.D.
Product	Quantity	Description	Price	Disc %	Amount	Tax
REGRK-BCT-3	6.00 Ea	RegenLab PRP SINGLE BCT Tubes, 3 Tubes per pkg 6.00 / 019 30.10.2014	236.25Ea	0.00	1,417.50	Non
AMTS-N	3.00 PKG	MCure MicroPen - Replacement Needles (6 per Pkg)	77.70PKG	0.00	233.10	Non
AMTS - N	2.00 Ea	MCure MicroPen - Replacement Needle (each)	12.95Ea	0.00	25.90	Non
REGVFLa881	1.00 PKG	Vampire FaceLift Patient Brochure, 50 per pkg	35.00PKG	0.00	35.00	Non
REGVlicense	6.00 Ea	Vampire FaceLift Monthly License	0.00Ea	0.00	0.00	Non
REGVFLBanner	1.00 Ea	Vampire FaceLift Pop-up Banner, 6 Ft.	0.00Ea	0.00	0.00	Non
REGVFLDVD	1.00 Ea	Vampire FaceLift Physician to Patient Marketing Elements	0.00Ea	0.00	0.00	Non
Shipping	1.00	Shipping Charges	37.62	0.00	37.62	Non

Figure 3 Eclipse invoice with VAMPIRE FACELIFT license¹⁶²

The invoice does not refer to “Vampire Facelift” as a trademark, does not define what is protected by the “license,” and includes no provisions regarding the “license.” Nothing on the face of the invoice indicates that the purchaser had any knowledge of legal obligations under a license or sublicense. We specifically reject Respondent’s contention that the centrifuge sales invoice was equivalent to a license or sublicense. Because there is no evidence of a license or sublicense between Dr. Gallo and Eclipse, or any agreement except a centrifuge sales invoice, we find that Dr. Gallo was not Respondent’s licensee.

While the lack of any agreement with Dr. Gallo is sufficient to rebut Respondent’s contention that Dr. Gallo was his licensee via the Eclipse agreement, we also note that Respondent’s mark VAMPIRE FACIAL was not the subject of the Eclipse agreement, which was limited to the mark VAMPIRE FACELIFT, and that Dr. Gallo,

¹⁶² 71 TTABVUE 9.

Ms. Kardashian's plastic surgeon, submitted a declaration categorically denying any relationship with Respondent.¹⁶³

We find that the Kardashian Instagram post and television show contributed to the existing public perception that "vampire" names cosmetic procedures involving PRP. Dr. Gallo's declaration avers that he has "over 23 years of experience in facial plastic surgery," and "expertise in skincare, rejuvenation, and anti-aging procedures," and confirms that "vampire facial" is not regarded as a source indicator:¹⁶⁴

It is my understanding and belief based on my experience that consumers use and understand the term "vampire facial" as a generic or descriptive term referring to a medical procedure known as "platelet rich plasma," which is the Procedure that I performed on Ms. Kardashian.

The record includes an advertisement for Respondent's book, Vampire Facelift®: The Secret Blood Method to Revive Youth & Restore Beauty, published in paperback 2013.¹⁶⁵ Respondent testified that he described the Vampire Facelift for the book as follows:¹⁶⁶

Vampire Facelift® is a specific way to use blood-derived growth factors to rejuvenate the face. The US Patent & Trademark office recognized the specific trade secrets used in the Vampire Facelift as valuable and unique, granting protection to Dr. Runels' ideas and methods. Many tried to duplicate the Vampire Facelift procedure without success.

This description is in the advertisement for the book, and we find that this description of "Vampire Facelift" by Respondent does not show trademark use, but also

¹⁶³ 51 TTABVUE 3-4.

¹⁶⁴ 51 TTABVUE 4.

¹⁶⁵ 50 TTABVUE 85.

¹⁶⁶ 49 TTABVUE 196-197.

contributes to the existing public perception that “vampire” names cosmetic procedures involving PRP injections. In fact, Respondent explicitly states that “Vampire Facelift” identifies a “specific way,” or a procedure, which is a trade secret protected by the USPTO (which protects only patents and trademarks).

To counter the evidence that the public perceives “vampire” as naming PRP injections for cosmetic applications, Respondent asserts that “vampire” marks are recognized as source indicators for procedures emanating from him or his licensees, as shown by “numerous online articles” which associate him with the marks at issue:¹⁶⁷

As Charles Runels, an Alabama cosmetic doctor (who’s better known as the creator of the **Vampire** Facial, made famous when Kim Kardashian had the procedure done on TV), explains, the O-Shot uses PRP to stimulate the growth of new cells in a woman’s vaginal walls and clitoris. January 22, 2014, <https://www.harpersbazaar.com/beauty/health/advice/a1476/orgasm-injection-0214/>¹⁶⁸

The O Shot – a Vampire Treatment for Vaginal Wellness

The O Shot combines two things I am interested in: maintaining and restoring vaginal and sexual health; and the so-called **Vampire** Facial. ...It was a Dr Charles Runels, who back in 2011 trademarked the **Vampire** Facial, and then came up with the idea for the O Shot to apply PRP to the vaginal walls. October 31, 2018, <https://truthinaging.com/review/the-o-shot/>¹⁶⁹

Kim Kardashian, has proven her dedication to her craft by getting the bloodletting **Vampire** Facelift. According to the New York Daily News, “The **Vampire** Facelift - trademarked by Alabama doctor Charles Runels [-] draws blood from the patient’s arm with a needle and separates the platelets into a platelet-rich plasma (PRP) using a centrifuge....”

¹⁶⁷ 108 TTABVUE 41.

¹⁶⁸ 69 TTABVUE 85.

¹⁶⁹ 69 TTABVUE 81.

November 6, 2018, www.therichest.com/shocking/15-things-you-wont-believe-celebs-do-to-look-fabulous¹⁷⁰

Combining PRP with HA was popularised by American Dr Charles Runels as the **Vampire** Facelift a few years ago.

December 20, 2018 Aesthetic Medical Practitioner¹⁷¹

Kim Kardashian's **Vampire** Facelift

A platelet- rich plasma (PRP) treatment, or **Vampire** Facial, as trademarked by Charles Runels in the US, was made famous by Kim Kardashian (naturally) when she shook Instagram with a post of her bloodied face.

February 20, 2019, <https://www.timeslive.co.za/sundaytimes/lifestyle/fashion-and-beauty/2019-02-20-is-a-blood-facial-bloody-good-for-your-skin>¹⁷²

While Harper's Bazaar is a magazine of national circulation in the United States, the online story does not refer to Respondent as the owner of the trademark registration for Vampire Facial, but as its "creator," while Kim Kardashian is identified as responsible for the procedure's fame. Another article describes Respondent as the "popularizer" of the Vampire Facelift "combining PRP with HA," and so describes Respondent as making a procedure popular, not promoting the mark for the

¹⁷⁰ 69 TTABVUE 30-31.

¹⁷¹ 69 TTABVUE 35 (Australian publication). We note that the probative value, if any, of foreign information sources must be evaluated on a case-by-case basis. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1835 (Fed. Cir. 2007) ("Information originating on foreign websites or in foreign news publications that are accessible to the United States public may be relevant to discern United States consumer impression of a proposed mark."). The Board's primary viewing court has found foreign publications may affect U.S. consumer perception on medical matters based on "the growing availability and use of the internet as a resource for news, medical research results, and general medical information." *Id.* at 1835. Because this case involves cosmetic medicine procedures, we find foreign articles available on the internet may have affected the perception of U.S. providers and consumers of injections to facilitate orgasm.

¹⁷² 69 TTABVUE 43 (South African publication). This was a reprint from another South African publication which Respondent also lists.

procedure.¹⁷³ The U.S.-based articles emanate from blogs of unknown circulation. We do not find these articles clearly show recognition of “vampire” as anything but the name of the PRP injection, with some reference to Respondent being a noted provider of the treatment.

We also give little credence to Respondent’s testimony that he “invested significant time and money in promoting the registered marks.”¹⁷⁴ As support for this statement, Respondent cites his own use of the registered marks and the services for which they are registered on his website.¹⁷⁵ Because Respondent already had a website where he promoted his cosmetic medicine services, and offers no details as to any specific expenditures except staff salaries, it would not seem that adding the new marks and PRP injection services required a large outlay of time and money. In

¹⁷³ In an October 22, 2017 transcript linked to the “Who is Charles Runels?” page of Respondent’s website, Respondent Runels confirms that “vampire” has been associated with cosmetic applications of PRP since the cosmetic applications were introduced:

“The press had used the word ‘vampire’ already in association with PRP, but they were calling it vampire therapy, and I didn’t think ... I particularly don’t want to have therapy, or they were calling it vampire filler, and I didn’t want to be filled up, but what I could see it was actually doing was causing a facelift. Lifting the tissue away from the skeleton, away from the skull, and truly lifting it, away back into younger shape. That’s what I did with the material, and I said let’s call it the vampire facelift. I trademarked it, and I started recruiting physicians who would agree to follow the specific method that I developed, and to see if I could protect that method, and it just went crazy.”

92 TTABVUE 102. This transcript was marked confidential but we find this statement merely corroborates Respondent’s earlier statements regarding the origin of his use of “vampire.”

¹⁷⁴ 64 TTABVUE 39.

¹⁷⁵ 64 TTABVUE 39-40.

addition, the attached website pages all are dated July 31, 2019, and Respondent offers no details as to when the marks were added to the pages.

Even though Runels describes pages on his website as “publicly available” in his declaration (Par. 147-152 introducing, Exhibits 159-168), he has designated the webpages as confidential and barred from public view.¹⁷⁶ Moreover, even if the pages were publicly available, Respondent provides no information about the traffic to his website, leaving us to guess whether the website had any traffic. *In re Brouwerij Bosteels*, 96 USPQ2d 1414, 1424 (TTAB 2010) (“Insofar as applicant’s website is concerned, although the alleged mark is displayed thereon, there is no information with respect to the number of visitors to the website. In the absence thereof, we are unable to determine whether a significant number of people in the United States have even viewed the alleged mark at the website.”).

Finally, we find that Respondent’s evidence regarding his efforts to police his registered marks not only fail to demonstrate that he succeeded in stopping third party use, but make clear that there has been widespread third-party use of “vampire” to describe PRP cosmetic procedures. In other words, the hundreds of cease and desist letters sent by Respondent and his staff include details as to third-party uses across multiple public platforms over multiple years.¹⁷⁷ For example:

- Respondent’s May 23, 2016 letter sought removal of uses of VAMPIRE FACELIFT from a menu bar listing procedures performed which appeared on each page of a third-party website, removal of VAMPIRE FACELIFT uses from the URL, removal of the VAMPIRE FACELIFT page describing

¹⁷⁶ 87-93 TTABVUE. Because some pages state that the information is available only to “members,” we do not treat this as an inadvertent designation.

¹⁷⁷ 95 and 96 TTABVUE.

the procedure, more than a dozen tweets on the Twitter account on VAMPIRE FACELIFT or VAMPIRE FACIAL from November 16, 2011 to May 17, 2016, and more than a dozen Facebook posts on VAMPIRE FACELIFT and VAMPIRE FACIAL from January 5, 2015 to May 17, 2016.¹⁷⁸

- Respondent’s letter dated January 4, 2017 sought removal of uses of VAMPIRE FACELIFT and VAMPIRE FACIAL on the website in both 2015 and 2016, and uses of VAMPIRE FACELIFT and VAMPIRE FACIAL which occurred over four years (2013-2016) in multiple Twitter posts and over five years (2012-2016) in multiple Facebook posts. ¹⁷⁹
- Respondent’s September 4, 2018 email sought removal of more than two dozen uses of VAMPIRE FACELIFT and VAMPIRE FACIAL from the website, Facebook, and Twitter accounts, noting: “This means that Mrs. Moffett and Mrs. Hall have been actively marketing their procedure by infringing on the Vampire Facial® trademark/service mark since at least March 11, 2016.”¹⁸⁰

Our conclusion based on this evidence is that third-party usage of the term “vampire” to describe cosmetic PRP procedures has been consistent over many years. We acknowledge Respondent’s testimony that many people complied with his request to cease use,¹⁸¹ but we do not conclude from this that Respondent’s competitors using “vampire” to describe their PRP procedures were acknowledging Respondent’s trademark claim. Merely ceasing use as requested may indicate nothing more than a wish to avoid Respondent’s threatened litigation. *In re Wella Corp.*, 565 F.2d 143, 196 USPQ 7 n.2 (CCPA 1977) (“Appellant argues that various letters (of record) from competitors indicating their discontinuance of use of its mark upon threat of legal

¹⁷⁸ 96 TTABVUE 168-171.

¹⁷⁹ 96 TTABVUE 401-404.

¹⁸⁰ 95 TTABVUE 359-361.

¹⁸¹ 96 TTABVUE 3-11. Letters to or from users outside the United States are not relevant.

action are evidence of its distinctiveness, but we agree with the TTAB that such evidence shows a desire of competitors to avoid litigation rather than distinctiveness of the mark.”); *Milwaukee Elec. Tool Corp. v. Freud Am., Inc.*, 2019 USPQ2d 460354, *20 (TTAB 2019) (“Especially given that many competitors contacted by Freud denied Freud’s asserted right in the color red for cutting tools, we find that competitors likely acquiesced to Freud’s assertion of its exclusive right to use the color red on saw blades to avoid litigation.”).

More importantly, Respondent provided the evidence that hundreds of third-party users did not cease their use when contacted by Respondent. Respondent submitted under seal an eighty page “imposters” chart listing more than 600 individuals or businesses across the United States that use the terms he has registered for PRP injections, and continue to do so even after receiving a cease and desist communication from Respondent.¹⁸²

In addition, notwithstanding Respondent’s testimony that he sought to correct such uses, more recent media references continue to use “vampire” to name the procedures, even if acknowledging a version of Respondent’s claim:¹⁸³

That same year, blood injections rocketed into the world of trendy cosmetics when doctors in Miami gave Kim Kardashian a “**vampire** facelift” (another of Runels’ trademarked PRP procedures, it turns out, where blood is dripped all over the T-zone while attacking the area with needles). Afterward, Kardashian

¹⁸² 64 TTABVUE 38; 87 TTABVUE 40-121. The chart lists the location of the user, and the 600 number does not include those third-party users located outside the United States or listed only by name with no location.

¹⁸³ Sometime after the story published and Respondent asserted ownership of the trademark, the publisher linked Respondent’s website to the article. 49 TTABVUE 121-122. We do not regard such an addition as an effective counter to an initial use as the name of the PRP cosmetic procedure.

posted a selfie of her blood-soaked face (when the photo went viral, her doctor received an official “cease and desist” call from Runels, who explained he owned the trademark).

September 15, 2016, The Guardian¹⁸⁴

What Is a **Vampire** Facial? Everything to Know About the Skin Treatment ... No, it’s not Halloween make up, it’s actually one of the latest treatment trends in skin care, also known as a “**vampire** facial.” Celebrities, including Kim Kardashian West and Bar Refaeli, are fans of the facial, which might look quite scary, but boasts big-time results.

For more **vampire**-inspired treatments:

- Blood-Infused Skin Care: We Tried the \$1,400 Treatment
- People Are Injecting Themselves With Blood From Teens and We’re So Scared
- You Can Make Your Brows Thicker With Your Own Blood

October 26, 2017, <https://www.allure.com/story/vampir-facial/Verso=tru>¹⁸⁵

Two clients contract HIV following procedures at New Mexico spa as DOH warns of risk from ‘**Vampire** facial’

Two people who most likely contracted HIV at a now-defunct New Mexico spa during a so-called **Vampire** Facial now face a lifetime of suppression therapy.

The procedure itself is safe, if done correctly, said the Cellular Medicine Association in a statement on its official **Vampire** Facial website. ... “The providers in New Mexico under investigation were imposters who were not licensed to use our name ‘**Vampire** Facial,’ were never licensed to use the name, were never properly trained, and were never on our list of certified providers.”

April 29, 2019, New York Daily News:¹⁸⁶

Are **Vampire** Facials Safe? How to Get the Glow Without the Risks?

Since my first day at RealSelf, the question I’ve most often heard from friends is, “what’s up with the **Vampire** Facial?”

But earlier this week, CNN published a story about two women who may have contracted HIV from their **Vampire** facials, raising valid concerns about safety.

¹⁸⁴ 50 TTABVUE 80.

¹⁸⁵ 50 TTABVUE 65-69.

¹⁸⁶ 69 TTABVUE 7-10.

Arizona plastic surgeon Dr. Cheri Ong, who regularly performs the procedure says, “**Vampire** facials are super safe if basic medical procedures are followed...”

What Is a **Vampire** Facial?

“Hollywood uses the term a lot,” says Dr. Ong. “But Dr. Charles Runels first coined it. The procedure is trademarked, and the name should only be used by providers specifically trained in his techniques to help maintain quality control and consistency in results.” “The true **Vampire** Facial that he describes begins by drawing the patient’s blood then processing it, either with a centrifuge or a PRP-processing system. ...”

May 2, 2019, realself.com:¹⁸⁷

See BellSouth Corp. v. DataNational Corp., 60 F.3d 1565, 35 USPQ2d 1554, 1557 (Fed. Cir. 1995) (“A descriptive term may be generic for a designation ab initio, or it may become generic over time through common usage if the otherwise non-descriptive term is not policed as a trademark and it is commonly used to describe a type of product.”) (internal citation omitted). *See also* J. Thomas McCarthy, 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION 17:17 (5th ed) (“the focus in the generic name cases is not on how often plaintiff has sued or not sued others, but what has been the effect of not suing upon use of the term by competitors and hence, upon use by customers. Lack of prosecution is an omission that may, or may not, have led to widespread customer usage of the term in a generic name sense.”).

Based on the evidence of record, we find that the term “vampire” is the generic term for PRP treatments for cosmetic medicine applications.

With respect to the combined term VAMPIRE NIPPLE LIFT, we find the combination of generic terms conveys the same connotation as that of the individual

¹⁸⁷ 69 TTABVUE 12-15.

generic terms; there is no difference in connotation resulting from combining the terms. *See In re MetPath, Inc.*, 223 USPQ 88, 89 (TTAB 1984) (“In view of the common significance of the term ‘Pap test’ as a test for detecting cancer of the female reproductive tract, we are of the opinion that members of the general consuming public who encounter the designation ‘MALE P.A.P. TEST’ used in connection with applicant’s testing services are likely to immediately perceive the designation as an indication that applicant’s services involve tests for the detection of cancer of the male reproductive tract; that is, tests for men which are analogous in nature to the ‘Pap test’ for women.”). We find that the relevant public’s perception of the term VAMPIRE NIPPLE LIFT is that it is a generic term for “non-invasive cosmetic medical procedure, namely, isolation and injection of blood-derived growth factors, including but not exclusive to platelet rich plasma, for the correction of inverted nipples.”

Accordingly, the petition for cancellation based on genericness is granted with respect to Registration No. 4131408 (VAMPIRE NIPPLE LIFT).

As stated earlier, claims of genericness and mere descriptiveness both depend on facts regarding public perception of the licensed mark, and whether the mark names the goods or immediately conveys information about the goods. *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 128 USPQ2d at 1373 n.3. (A generic mark is “the ultimate in descriptiveness.”). With respect to Registration No. 4131408, we find that the same evidence found sufficient to prove that the mark VAMPIRE NIPPLE LIFT is generic also is sufficient to show that the mark VAMPIRE NIPPLE LIFT is merely descriptive.

The petition for cancellation based on based on mere descriptiveness is granted with respect to Registration No. 4131408 (VAMPIRE NIPPLE LIFT).

2. **ORGASM SHOT**

Registration No. 4100383 for the mark **ORGASM SHOT** issued on the Supplemental Register, with a disclaimer of **SHOT**, for “non-invasive cosmetic medical procedure namely, the injection of blood-derived growth factors including platelet rich fibrin matrix within the Gspot, clitoris, and/or other vaginal structures to rejuvenate the tissue and facilitate the female orgasm.”

The generic name by which a [service] is known is not a mark which can be registered on the Supplemental Register under section 23 because such a name is incapable of distinguishing applicant’s [services] from [services] of the same name . . . by others.” *Clairol, Inc. v. Roux Distrib. Co.*, 280 F.2d 863, 126 USPQ 397, 398 (CCPA 1960). Accord *Turtle Wax Inc. v. Blue Coral Inc.*, 2 USPQ2d 1534, 1536 (TTAB 1987) (“Terms that are precluded from registration on the Supplemental Register include generic designations...”).

Any term that the relevant public understands to refer to the genus of services is generic and unregistrable, even if there are other generic terms for those services. *In re 1800Mattress.com IP LLC*, 586 F.3d 1359, 92 USPQ2d 1682, 1685 (Fed. Cir. 2009) (“We also disagree with Dial-A-Mattress’s assertion that there can only be one generic term, which is ‘online mattress stores.’ Instead, any term that the relevant public understands to refer to the genus of ‘online retail store services in the field of mattresses, beds, and bedding’ is generic.”); *Clairol, Inc. v. Roux Distrib. Co.*, 126

USPQ at 398 (“The same merchandise may, and often does, have more than one generic name.”); *In re ActiveVideo Network, Inc.*, 111 USPQ2d 1581 (TTAB 2014) (“as a marketplace reality, the apt term ‘Cloud TV’ is much shorter and more nimble than the cumbersome phrases that Applicant offers as generic alternatives.”). The McCarthy treatise sums it up: “Any product may have many generic designations. Any one of those is incapable of trademark significance.” J. Thomas McCarthy, 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION 12:9 (5th ed).

Registration on the Supplemental Register is a concession that the term is not inherently distinctive. *In re Haden*, 2019 USPQ2d 467424, *1 (TTAB 2019) (“Inasmuch as Applicant has amended the application to seek registration on the Supplemental Register, the mark is at best merely descriptive.”).

Respondent submitted the required disclaimer of the generic matter SHOT on the Supplemental Register. *See In re The Consumer Protection Firm PLLC*, 2021 USPQ2d 238 (TTAB 2021) (“Applicant disclaimed FIRM.COM on the Supplemental Register and therefore has conceded it is generic.”); *In re Haden*, 2019 USPQ2d 467424, at *5 (“Generic matter must be disclaimed to permit registration on the Supplemental Register.”); TMEP 1213.03(b) (“If a mark is comprised in part of matter that, as applied to the goods or services, is generic or does not function as a mark, the matter must be disclaimed to permit registration on the Principal Register (including registration under §2(f) of the Act) or on the Supplemental Register.”). While Respondent’s disclaimer of a term in a mark on the Supplemental Register essentially concedes that the disclaimed term is generic, we additionally take judicial notice that

the term SHOT is synonymous with “injection.”¹⁸⁸ That is, even if the term had not been disclaimed on the Supplemental Register, we would find that the term SHOT is generic as applied the registered cosmetic medical procedure namely, the injection, or shot, “to rejuvenate the tissue and facilitate the female orgasm.”

We find the term ORGASM also is generic as applied to the registered services. The term “orgasm” appears in the recitation of registered services as the purpose, or key aspect, of the services. The term for a key aspect of the genus of services, such as its purpose or function, is unregistrable. *See In re Gould Paper Corp.*, 5 USPQ2d at 1110 (SCREENWIPE held generic for an anti-static cloth used for cleaning computer and television screens); *In re Cent. Sprinkler Co.*, 49 USPQ2d 1194, 1198 (TTAB 1998) (“The simple fact is that ATTIC, when applied to sprinklers for use in an attic, ‘immediately and unequivocally describes the purpose, function and nature of the goods.’”); *In re Reckitt & Colman, N. Am. Inc.*, 18 USPQ2d 1389 (TTAB 1991) (PERMA PRESS generic for soil and stain removers for use on permanent press products) In sum, we find that “ORGASM” is the generic term for a type of shot to facilitate orgasms, and “SHOT” is the generic term for cosmetic medical procedures by the way of injections.

Considering the mark as a whole, we find the combination of the generic terms ORGASM and SHOT does no more than form the new generic term ORGASM SHOT, which the general public who seek or offer injections to facilitate the female orgasm,

¹⁸⁸ SHOT is defined as “a medical or narcotics injection.” *Merriam-Webster.com Dictionary*, <https://www.merriam-webster.com/dictionary/shot>. Accessed 25 Sept. 2021.

will understand to refer to the category or class of services identified in the registration. See *In re Virtual Independent Paralegals, LLC*, 2019 USPQ2d at *8 (“Combining VIRTUAL PARALEGAL and INDEPENDENT PARALEGAL into VIRTUAL INDEPENDENT PARALEGALS provides no additional or changed meaning.”); *In re ActiveVideo Network, Inc.*, 111 USPQ2d at 1194 (“[W]e agree with the Trademark Examining Attorney that the evidence of record clearly shows that ‘CLOUD TV,’ the compound created by the combination of the individually generic terms ‘cloud’ and ‘tv,’ is itself generic inasmuch as no new meaning beyond the individual meaning of the components is created by the combination.”).

This finding is corroborated by the record evidence of generic use of “orgasm shot” in online publications:

PRP has also been injected into the vagina, in a procedure called “O-shot” or “**orgasm shot**” with claims that this will improve orgasms.

https://en.wikipedia.org/wiki/Plateletrich_plasma¹⁸⁹

I Got an **Orgasm Shot** and Here’s What happened

Yeah, it’s a blood transfusion to your clit.

...

So, what exactly is an **Orgasm Shot** (O-Shot)? If you’ve ever heard of Kim Kardashian’s infamous vampire facial, or if you were intrigued enough to read my story on it earlier this month, you’re already halfway to understanding.

*Nylon Magazine (January 26, 2018)*¹⁹⁰

What is an **orgasm shot**? And a vampire breast lift? The hottest surgeries decoded

Classic treatments like lip fillers are still among the most popular, but these days, you’re nobody one if you haven’t at least heard of the vampire breast lift.

Or the **orgasm shot**.

¹⁸⁹ 55 TTABVUE 3, 12.

¹⁹⁰ 69 TTABVUE 75-76.

*<https://www.independent.ie/style/beauty/body/what-is-an-orgasm-shot-and-a-vampire-breast-lift-the-hottest-surgeries-decoded-346.html>
25.11.2019¹⁹¹*

Petitioner submitted her own declaration as a doctor and sexual and health wellness specialist in the field of anti-aging, functional, and regenerative medicine, averring that the mark in Registration No. 4100383 [ORGASM SHOT] is understood by the relevant purchasing public to mean a “[n]on-invasive cosmetic medical procedure namely, the injection of blood-derived growth factors including platelet rich fibrin matrix within the Gspot, clitoris, and/or other vaginal structures to rejuvenate the tissue and facilitate the female orgasm” and that it “is commercially implausible for me and others to offer these services to the relevant purchasing public without reference to these functional, generic terms to describe the services.”¹⁹²

Respondent’s cease and desist letters corroborate the evidence of third parties using the term ORGASM SHOT to identify the PRP cosmetic injection. Below are a sample of the third party uses described:

Respondent’s March 20, 2015 letter sought removal of ORGASM SHOT from the website, noting it appeared in the section for “Our Services,” under the tabs for “Skin Rejuvenation,” “Vampire or PRP (Platelet Rich Plasma) Treatments,” “Vampire Facelift,” “Orgasm Shot (The 0 Shot),” and “Ageless Lift”).¹⁹³

Respondent’s April 9, 2015 letter sought removal of ORGASM SHOT from the the website URL and a linked video.¹⁹⁴

¹⁹¹ 52 TTABVUE 174-175 (Irish publication).

¹⁹² 54 TTABVUE 13.

¹⁹³ 66 TTABVUE 75.

¹⁹⁴ 66 TTABVUE 390.

Respondent's June 1, 2016 letter sought removal of ORGASM SHOT from 13 different pages on the website, including the homepage and "procedures" page.¹⁹⁵

Respondent's November 14, 2016 letter sought removal of ORGASM SHOT from the URL for the website and the Linked in page.¹⁹⁶

Respondent's April 17, 2017 letter sought removal of ORGASM SHOT from the Facebook and Twitter pages, noting that the "post of July 11, 2016 contains infringing references to the O-Shot® and Orgasm Shot®."¹⁹⁷

Challenging the evidence that ORGASM SHOT is a generic term for the registered services offering PRP injections to facilitate orgasm, Respondent contends that the public references to ORGASM SHOT associate the mark with Respondent, and that Respondent's promotional efforts, including his enforcement of his mark, have resulted in the term ORGASM SHOT being perceived as Respondent's mark.¹⁹⁸ We disagree. As evidence that he is associated with the term ORGASM SHOT, Respondent points to the same article in Nylon cited above, pointing out that he is credited with invention of administering the shot to the clitoris, though the alternative term "O SHOT" is used:

Like a vampire facial, an O-Shot is a Platelet Rich Plasma (PRP) treatment that's geared toward rejuvenating the sensations in both the clitoris and G-Spot, and it is the second brainchild of Dr. Charles Runels, M.D. While PRP had been regularly used in sports medicine since the 1980s, with just about every injured athlete since then receiving PRP shots, it wasn't until 2011 when Dr. Runels introduced the treatments to the world of cosmetics in the form of his trademarked Vampire Facial, that the wonders of PRP really started to catch on. As soon as he saw the booming success associated with his Kardashian-approved facial, he pioneered the O-Shot to pump vaginal tissue

¹⁹⁵ 67 TTABVUE 17-18.

¹⁹⁶ 66 TTABVUE 371.

¹⁹⁷ 66 TTABVUE 294.

¹⁹⁸ 108 TTABVUE 34, 37-44.

full of the same regenerative blood cells known for getting some of our favorite athletes off the bench and back on the court.

*Nylon Magazine (January 26, 2018)*¹⁹⁹

The reference in the press to Respondent's "trademarked" Vampire Facial does not clearly indicate that Respondent claims rights in the term "Vampire Facial," but instead could be read as his claim to have introduced the PRP cosmetic treatment "in the form of the "Vampire Facial."

As to Respondent's reliance on his promotion and enforcement of the ORGASM SHOT, the same deficiencies already discussed apply here. Respondent's promotion of the ORGASM SHOT mark is limited to his website, email to an unknown number of recipients, and word of mouth, which we construe as including his demonstrations to prospective and actual licensees. Respondent has not made clear how much of his website is available to the general public, and barred much of his website evidence from public view in this proceeding. Respondent has offered no facts regarding traffic to his website, or views of the pages in which the ORGASM SHOT is promoted. Respondent offers no facts regarding how often he or his licensees have offered the ORGASM SHOT injections to facilitate orgasm.

While Respondent has more than a thousand licensees for the mark ORGASM SHOT, there is scant evidence as to how the licensees use the mark and whether that use is perceived by the public as trademark use. Also as discussed, we find Respondent's enforcement activities, which cease if there is no response to his letters, are more effective in acquiring licensees than stopping the spread of third-party

¹⁹⁹ 69 TTABVUE 75-76.

generic use of ORGASM SHOT. Compare *Zimmerman v. Nat'l Ass'n of Realtors*, 70 USPQ2d 1425, 1430 (TTAB 2004) (“To the extent that individuals or local real estate groups misuse these registered terms, the previous litigation with Ms. Freeman illustrates the extent of respondent’s policing efforts with respect to such uses, demonstrates that respondent does not permit such steps to go uncontested, and shows that respondent continually takes affirmative steps to emphasize the proprietary status of its collective service marks.”). In any event, “[g]eneric terms cannot be rescued by proof of distinctiveness or secondary meaning no matter how voluminous the proffered evidence may be.” *Northland Aluminum Prods., Inc.* 777 F.2d 1556, 227 USPQ 961, 962 (Fed. Cir. 1985) (alteration in original) (quoting Examiner); see also *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 290 F.2d 845, 129 USPQ 411 (CCPA 1961) (“The examiner erred in accepting the showing of ‘distinctiveness’ in granting the registration because no matter what the market situation may have been as to indication of origin or secondary meaning, the common descriptive name of the product cannot become a trademark owned exclusively by one vendor.”).

We find that the plain meaning of the terms ORGASM and SHOT when combined into the term ORGASM SHOT and used in connection with “[n]on-invasive cosmetic medical procedure namely, the injection of blood-derived growth factors including platelet rich fibrin matrix within the Gspot, clitoris, and/or other vaginal structures to rejuvenate the tissue and facilitate the female orgasm” is the generic term for a type of PRP injection designed to facilitate orgasms.

Accordingly, the petition for cancellation based on genericness is granted with respect to Registration No. 4100383 (ORGASM SHOT).

VIII. FRAUD

Petitioner pleads fraud based on unlawful use against all registrations, and pleads fraud based on knowledge of third-party generic use against the registrations that include the term VAMPIRE: Registration Nos. 3965319 (VAMPIRE FACELIFT); 4121687 (VAMPIRE BREAST LIFT); 4131408 (VAMPIRE NIPPLE LIFT); and 4402898 (VAMPIRE FACIAL)). As set forth earlier, we decline to find that licensee estoppel bars these fraud claims.

A trademark applicant commits fraud when he knowingly makes false, material representations of fact with an intent to deceive the Patent and Trademark Office. *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1939 (Fed. Cir. 2009); *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1501 (TTAB 2017).²⁰⁰

Fraud is not easy to prove; “the very nature of the charge of fraud requires that it be proven ‘to the hilt’ with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party.” *In re Bose*, 91 USPQ2d at 1939 (citing *Smith Int’l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981)). There is a material legal distinction

²⁰⁰ See also J. Thomas McCarthy, 3 McCarthy on Trademarks and Unfair Competition 20:18 (5th ed.) (“Great care should be taken in ascertaining the accuracy of information contained in the verified application papers, since fraud in the procurement of a trademark registration can be used as a ground of opposition, as a ground of a Petition to Cancel in the Patent and Trademark Office or in the courts, as a ground for precluding a party from relying upon a registration in administrative proceedings, as an affirmative defense to infringement, as a basis for the defense of unclean hands, as a basis for a civil action for damages for false or fraudulent registration, or as the basis of an antitrust suit.”).

between a ‘false’ representation and a ‘fraudulent’ one, the latter involving an intent to deceive, whereas the former may be occasioned by a misunderstanding, an inadvertence, a mere negligent omission, or the like.” *In re Bose*, 91 USPQ2d at 1940, (citing *Kemin Indus., Inc. v. Watkins Prods., Inc.*, 192 USPQ 327, 329 (TTAB 1976)).

A. Fraud based on Unlawful Use in Commerce

Respondent filed the use-based applications underlying the subject registrations on September 12, 2010 (VAMPIRE FACELIFT and PRIAPUS SHOT); March 18, 2011 (ORGASM SHOT and O SHOT); August 17, 2011 (VAMPIRE BREAST LIFT and VAMPIRE NIPPLE LIFT); and January 18, 2013 (VAMPIRE FACIAL). In support of her claim that on those dates Respondent “made material, false representations under oath that he knew of were false at the time they were made” as to his lawful use of the marks for the medical procedures listed in each application, Petitioner contends that Respondent “was not legally authorized to provide” the identified medical services.²⁰¹ Accordingly, we turn first to whether Petitioner has established Respondent’s unlawful practice of cosmetic medicine at the time the applications were filed, the factual predicate for the fraud claim.

²⁰¹ 107 TTABVUE 34. Petitioner also contends that “there is no competent, reliable, admissible evidence in the Record that shows [Respondent] actually was using the marks in commerce when he applied for the registrations.” Petitioner asserts Respondent “is only legally authorized to provide the services in intrastate commerce.” 107 TTABVUE 15. To the extent Petitioner now argues no actual use in commerce as a new basis for fraud, we give no consideration to the unpleaded claim.

There is no question of a claim of nonuse having been tried by consent. The quoted language is the whole of Petitioner’s case. Petitioner does not argue that she submitted evidence sufficient to prove purely intrastate use as part of a nonuse fraud claim. Moreover, it is well settled that use of a mark with goods and services offered in a single state may suffice for use in interstate commerce. *See Christian Faith Fellowship Church v. Adidas AG*, 841 F.3d 986, 120 USPQ2d 1640, 1645 (Fed. Cir. 2016); *Larry Harmon Pictures Corp. v. Williams Rest. Corp.*, 929 F.2d 662, 18 USPQ2d 1292, 1295 (Fed. Cir. 1991).

The USPTO's longstanding practice has been to presume a mark's use in commerce is lawful unless the application record indicates a violation of federal law. *In re Stanley Brothers Social Enterprises, LLC*, 2020 USPQ2d 10658, *10 (TTAB 2020). *Accord In re Stellar Int'l, Inc.*, 159 USPQ at 51 ("The authority under Rule 2.69 [to question regulatory noncompliance] should, however, be exercised sparingly and only when the file suggests noncompliance with a regulatory act.").²⁰² "Whether the use of a mark is lawful under one or more of the myriad of regulatory acts involves two questions: (1) whether a court or government agency having competent jurisdiction under the statute involved has previously determined that party is not in compliance with the relevant statute; or (2) whether there is a *per se* violation of a statute regulating the sale of a party's goods." *Automedx Inc. v. Artivent Corp.*, 95 USPQ2d 1976, 1984 (TTAB 2010).

Unlike the norm for this claim, Petitioner does not specify a federal law or regulation which has been violated.²⁰³ However, we find relevant that all the

²⁰² See also Trademark Rule 2.69, 37 C.F.R. § 2.69 ("[w]hen the sale or transportation of any product for which registration is sought is regulated under an Act of Congress, the Patent and Trademark Office may make appropriate inquiry as to compliance with such Act for the sole purpose of determining lawfulness of the commerce recited in the application.").

²⁰³ Compare *O-M Bread, Inc. v. U.S. Olympic Comm.*, 65 F.3d 933, 36 USPQ2d 1041 (Fed. Cir. 1995) (Amateur Sports Act); *In re Pharmacann LLC*, 123 USPQ2d 1122 (TTAB 2017) (Controlled Substances Act); *Automedx Inc. v. Artivent Corp.*, 95 USPQ2d 1976 (TTAB 2010) (Food and Drug Administration regulations); *General Mills Inc. v. Healthy Valley Foods*, 24 USPQ2d 1270 (TTAB 1992) (Food and Drug Administration regulations); *Santinine Societa v. P.A.B. Produits*, 209 USPQ 958, 964 (TTAB 1981) (Fair Packaging and Labeling Act and Food, Drug and Cosmetic Act regulations). Compare *Western Worldwide Enterprises Group, Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137 (TTAB 1990) (Pleading that the Chinese government revoked registrant's right to export beer bearing the "TSINGTAO" mark to the United States, "failed to plead that the use by respondent or its predecessor in interest of "TSINGTAO" beer was unlawful under any statute of the United States.").

registered services are cosmetic medical procedures; that states regulate medical practice in part by issuing licenses to qualified practitioners, and that, unless Respondent was licensed to practice medicine by a state, Respondent could not lawfully render the medical services listed in the subject registrations. *Cf. Nationstar Mortg. LLC v. Ahmad*, 112 USPQ2d at 1374 (in connection with nonuse (but not unlawful use) fraud claim, the Board found “the record establishes that applicant could not lawfully hold himself out as a mortgage broker, insurance broker, or real estate broker because he was not properly licensed at the time he filed the application.”).²⁰⁴ Petitioner does not allege that there has been a final determination by an agency with competent jurisdiction that Respondent’s medical services listed in his registrations were unlawfully rendered at the time the underlying applications were filed, so we address whether the record demonstrates a per se violation as a basis for the asserted unlawful use.

The record shows Respondent has been licensed to practice medicine in the State of Alabama since 1988.²⁰⁵ The factual support for Petitioner’s claim that Respondent’s medical practice was precluded from rendering the registered services, making any rendering of the cosmetic medical procedures unlawful, lies with restrictions on Respondent’s state medical license by the Alabama Medical Licensure Commission

²⁰⁴ While Trademark Act Section 5, 15 U.S.C. 1055, specifies that applicants may rely on use of the mark by related companies, Respondent testified that he relied on his own of the medical performance of the procedures as the basis for each application, and only licensed use of the marks after they were registered. 64 TTABVUE 5, 6, 17, 19, 22, 25, 26, and 28.

²⁰⁵ 64 TTABVUE 3.

(AMLC).²⁰⁶ The documents from the AMLC are confidential, but the following facts also are based on admissions in the answer, which is not confidential.²⁰⁷

The AMLC restricted Respondent's medical license from November 9, 2009 to January 23, 2013, a period which includes the relevant filing dates for the applications underlying the subject registrations.²⁰⁸ The AMLC required Respondent to submit a detailed plan of practice, and Respondent's plan of practice included performing cosmetic procedures using fillers and lasers.²⁰⁹ The AMLC ordered Respondent, inter alia, to cease a therapy unrelated on its face to the services listed in the registrations or to the plan of practice, and to submit for prior approval a new plan of practice before making any change to his practice.²¹⁰

Respondent's practice did not include injection of blood-derived growth factors prior to entry of the AMLC's November 9, 2009 order, and Respondent did not at any time seek approval of the AMLC to add injection of blood-derived growth factors to his practice areas.²¹¹ Based on these admitted facts, Petitioner asserts that Respondent's injection of blood-derived growth factors to perform the registered

²⁰⁶ 107 TTABVUE 14-17 (brief); 72 TTABVUE 49-174 (confidential AMLC file). Petitioner also submits evidence relating to Respondent's work as a Food and Drug Administration clinical investigator. 107 TTABVUE 15, 33. Because Petitioner provided no link showing that Respondent's work on the FDA clinical trials was the same or related to the registered services, and the work and the services are not similar on their face, this evidence is irrelevant and will not be discussed.

²⁰⁷ 18 TTABVUE.

²⁰⁸ 18 TTABVUE 9-11; 72 TTABVUE 49, 104-107.

²⁰⁹ 18 TTABVUE 9-10; 2 TTABVUE 108-109, 113-114.

²¹⁰ 18 TTABVUE 9-11; 72 TTABVUE 105-107.

²¹¹ 18 TTABVUE 9-10.

medical services was a per se violation of the restrictions on his medical license, and unlawful. We disagree.

Respondent had a medical license at the time the relevant applications were filed. Respondent's license was restricted with respect to a procedure unrelated to either cosmetic procedures using fillers and lasers as described in Respondent's plan of practice, or cosmetic procedures using injection of blood-derived growth factors as described in Respondent's registrations. Petitioner has provided no foundation for a finding that the cosmetic procedures using fillers and lasers as described in Respondent's plan of practice differ in any significant way from cosmetic procedures using injection of blood-derived growth factors as described in Respondent's registrations, or that the difference would be deemed by the regulating body as equivalent to the unlawful practice of medicine.

To be clear, we are not finding that Respondent's activities at the time the underlying applications were filed fell within the restriction of his license. Our finding is limited to a finding that Petitioner has failed to establish a per se violation of those restrictions on Respondent's medical license which would be deemed by the AMLC as the unlawful practice of medicine (rather than a lesser infraction) so that Respondent's use of the mark in connection with performing the registered services was unlawful at the time the underlying applications were filed. Accordingly, Petitioner has failed to prove that Respondent's allegation of use in commerce in each underlying application was a misrepresentation (due to the unlawful practice of cosmetic medicine), a required element of the fraud claim.

The petition to cancel each registration for fraud based on unlawful use in commerce is denied.

B. Fraud based on Respondent's Knowledge of Third-Party Generic Use

With respect to the registered marks that comprise the term VAMPIRE and a disclaimed term, namely Registration Nos. 3965319 (VAMPIRE FACELIFT); 4121687 (VAMPIRE BREAST LIFT); 4131408 (VAMPIRE NIPPLE LIFT); and 4402898 (VAMPIRE FACIAL), Petitioner also alleges that the registrations were fraudulently procured because at the time the underlying applications were filed, Respondent “was aware others were using the marks,” falsely stated that he was “using the Disputed Marks on a substantially-exclusive basis,” and “intended the PTO to rely on his material, false statements.”²¹² See *Bart Schwartz Int’l Textiles, Ltd. v. FTC*, 129 USPQ at 260-261 (“it is clear to us that the registration ‘was obtained fraudulently’ within the meaning of Section 14(c) of the Lanham Act because of the misrepresentation in the declaration concerning what appellant knew to be the rights of others to use the word ‘fiocco.’”) and *G. Levor & Co., Inc. v. Nash, Inc.*, 123 USPQ 234, 235 (TTAB 1959) (“respondent, when it filed its application, must have known that others in the trade were using, and had the right to use, ‘CABRETTA’ as a descriptive name for leather.”).

The relevant filing dates for the VAMPIRE marks subject to this claim are September 12, 2010 (VAMPIRE FACELIFT); August 17, 2011 (VAMPIRE BREAST

²¹² 107 TTABVUE 33.

LIFT and VAMPIRE NIPPLE LIFT); and January 18, 2013 (VAMPIRE FACIAL).

With respect to whether Respondent possessed the required fraudulent intent when filing the applications, there is scant evidence to support Petitioner's argument that Respondent "intended the PTO to rely on his material, false statements."²¹³ As evidence that Respondent was aware of third party use of the term "vampire," Petitioner points to a specific statement in the specimen of use for Respondent's earliest-filed application:²¹⁴

To know how Selphyl does what Botox and Juvederm cannot (actually make the skin physiologically younger- -not just look younger), and why Selphyl is called the Vampire Facelift, watch this video (send an email to this address with "learn vampire" in the subject if you are an MD or nurse practitioner and wish to learn how to do the Vampire Facelift).

We disagree that the quoted sentence in the specimen shows Respondent's knowledge of third-party use of "Vampire" or "Vampire Facelift." Instead, Respondent seems to be using a shorthand reference to Selphyl as an injectable material like Botox and Juvederm; asserting that such injection of Selphyl "is called the Vampire Facelift;" and inviting those who wish to learn the injection procedure to contact Respondent. Moreover, to the extent that the record as a whole shows that Respondent was aware that others used the term "vampire" in connection with cosmetic medicine, this knowledge alone is insufficient to demonstrate fraudulent intent in seeking registration. *See Bart Schwartz Int'l Textiles, Ltd. v. FTC*, 129 USPQ at 260 ("The mere withholding of information as to the meaning of the [mark]

²¹³ 107 TTABVUE 33. o

²¹⁴ *Id.*, Registration No. 3965319, September 12, 2010 Specimen TSDR 1.

is not such a fraudulent withholding of information as to warrant cancellation of the mark.”).²¹⁵

Accordingly, because fraudulent intent is a critical element of the fraud claim, and Petitioner has failed to demonstrate that Respondent possessed that intent at the time the applications underlying the VAMPIRE registrations were filed, the fraud claim must fail. *In re Bose*, 91 USPQ2d at 1941 (“Subjective intent to deceive, however difficult it may be to prove, is an indispensable element in the analysis.”).

The petition to cancel Registration Nos. 3965319 (VAMPIRE FACELIFT); 4121687 (VAMPIRE BREAST LIFT); 4131408 (VAMPIRE NIPPLE LIFT); and 4402898 (VAMPIRE FACIAL) for fraud based on knowledge of third party generic use is denied.

²¹⁵ See also *Metro Traffic Control, Inc. v. Shadow Network, Inc.*, 104 F.3d 336, 41 USPQ2d 1369, 1373 (Fed. Cir. 1997) (“In this case, the Board determined that Mr. Schwartz’s statements [that SNI-NJ owned the “SHADOW TRAFFIC” mark, that he knew of no other entity who had the right to use another mark that was likely to cause confusion, and that the mark had become distinctive because of SNI-NJ’s “substantially exclusive” use for the five years preceding the application for registration], though false, were not uttered with the intent to mislead the PTO. Based on its review of the record, the Board found that the complex factual situation in this case apparently left Mr. Schwartz with an unclear understanding of the legal implications of his statement.”); *Smith Int’l, Inc. v. Olin Corp.*, 209 USPQ 1033 (TTAB 1981) (“Insofar as this record is concerned, there is nothing to suggest that the statement to the effect that no one else had a right to use the ‘DYNA-DRILL’ mark in commerce was based on anything other than an honest belief that, under the exclusive patent license, Smith and no other person, and that included Clark, had a right to use ‘DYNA-DRILL’ as a trademark as distinguished from the non-technical trademark use made by Clark over the years. In the absence of a willful intent to deceive, Smith cannot be charged on this alone with fraud in obtaining the registration.”).

IX. Decision

Judgment is entered as to Registration Nos. 4232767 for the mark VAMPIRE O SHOT and 4232768 for the mark VAMPIRE M SHOT on the claim that the mark was abandoned. The claims of abandonment based on naked licensing, genericness, fraud based on unlawful use, and fraud based on knowledge of generic use are dismissed without prejudice.

The petition to cancel is denied as to Registration Nos. 3965319 for the mark VAMPIRE FACELIFT; 4121687 for the mark VAMPIRE BREAST LIFT; and 4402898 for the mark VAMPIRE FACIAL. The claims of abandonment based on naked licensing, genericness, and mere descriptiveness (as to VAMPIRE FACIAL only) are barred by licensee estoppel, and the claims of fraud based on unlawful use and fraud based on knowledge of generic use are dismissed.

The petition to cancel is denied as to Registration No. 4103302 for the mark O SHOT. The claims of abandonment based on naked licensing, genericness, and mere descriptiveness (as to VAMPIRE FACIAL only) barred by licensee estoppel, and the claim of fraud based on unlawful use is dismissed.

The petition to cancel is denied as to Registration No. 3965320 for the mark PRIAPUS SHOT. The claim of abandonment based on naked licensing is barred by licensee estoppel, and the claim of fraud based on unlawful use is dismissed.

The petition to cancel is granted as to Registration No. 4100383 for the mark ORGASM SHOT on the claim that the mark is generic. The petition is dismissed as

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to the claims of abandonment based on naked licensing and fraud based on unlawful use.

The petition to cancel is granted as to Registration No. 4131408 for the mark VAMPIRE NIPPLE LIFT on the claims that the mark is generic and merely descriptive. The petition is dismissed as to the claims of abandonment based on naked licensing, fraud based on unlawful use, and fraud based on knowledge of generic use.

Registration Nos. 4232767 and 4232768 were cancelled under Trademark Act Section 8 in the course of this proceeding, and Registration Nos. 4131408 and 4100383 will be cancelled in due course.